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The "Evolving Written Description Doctrine" and the Search for Specificity (A.K.A. Adequacy is the Matter of Invention.)

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THE “EVOLVING WRITTEN DESCRIPTION DOCTRINE” AND THE SEARCH FOR SPECIFICITY (A.K.A. ADEQUACY IS THE MATTER OF INVENTION.)

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I. ABSTRACT

In 1996, the U.S. Supreme Court ruled in *Markman* that claim construction was a matter of law for the judge to decide.¹ There was hope in the patent bar that *Markman* would bring uniformity to claim construction and a reduction to the lengthy process of patent litigation.² Some authors report instead that the claim construction reversal rate is increasing.³ Other authors question the consistency of

¹ *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372 (1996).

² *Id.* at 390.

³ For example, reversal rates from 1983 to 2000 averaged 22%. Professor Moore's "detailed study of patent cases ... found that ... the CAFC reversed 22% in some form." Andrew T. Zidel, *Patent Claim Construction in the Trial Courts: A Study Showing the Need For Clear Guidance from the Federal Circuit*, 33 SETON HALL L. REV. 711, 739 (2003) (citing (then Professor, now Circuit Judge) Kimberly A. Moore, *Judges, Juries, and Patent Cases - an Empirical Peek Inside the Black Box*, 99 MICH. L. REV. 365, 367-68 (2000)). Then, from 1996 to 2003, reversal rates averaged 34.5%. ("The reversal rate ... from 1996 ... through 2003 is 34.5%." Kimberly A. Moore, *Markman Eight Years Later: Is Claim Construction More Predictable?*, 9 LEWIS & CLARK L. REV. 231, 233 (2005)). For 2001, reversal rates averaged 41.5%. (In 2001, "41.5%, of the cases having *Markman* Hearings had their claim construction reversed on appeal." Andrew T. Zidel, *Patent Claim Construction in the Trial*

the rulings from the Court of Appeals for the Federal Circuit.⁴ Circuit Judge Rader of the Federal Circuit recently named this controversy the "Evolving Written Description Doctrine."⁵

Behind this controversy primarily lies judicial interpretation of the patent statute, 35 U.S.C. § 112, with other statutes invoked periodically to support or counter differing opinions.⁶ These opinions suggest that the Court of Appeals for the Federal Circuit is invoking the judicial doctrine of possession to modify what the statutory requirements of enablement, best mode and definiteness.⁷ A patentee writing a broad embodiment may suffer invalidity for failing to satisfy the definiteness requirement. Conversely, an application with distinctly expressed embodiments may suffer from element exclusion and forfeit an otherwise acceptably broad embodiment.⁸

This article reviews the back-to-back cases of *JVW Enterprises, Inc. v. Interact Accessories, Inc.*,⁹ and *LizardTech, Inc. v. Earth Resource Mapping, Inc.*¹⁰ The subsequent en banc denial in *LizardTech* evoked a declaration by Circuit Judge Rader that the Federal Circuit has created an "Evolving Written Description Doctrine," in part over the court's invocation of the possession test.¹¹ Together with a discussion of the patent law and the judicial doctrines behind it, this article seeks to show that the Court of Appeals for the Federal Circuit is misapplying judicial doctrine (notably, the possession test) and lowering the standard for when this judicial doctrine applies.

Section I provides an overview of patent law and judicial doctrines that are

Courts: A Study Showing the Need For Clear Guidance from the Federal Circuit, 33 SETON HALL L. REV. 711, 741 (2003)). Irrespective of minor statistical differences, these articles state that judges facing claim construction rulings in patent cases have a chance of being overturned ranging from one-quarter to almost half. Thus, patent judges face a reversal rate several times higher than other areas of law. (The reversal rate in all circuits for all appeals (criminal and civil) from April 1, 2002 to March 31, 2003 was 9.4%. Federal Judicial Caseload Statistic, Table B-5, *Appeals Terminated on the Merits, by Circuit, During the 12-Month Period Ending March 31, 2003*, available at: <http://www.uscourts.gov/caseload2003/tables/B05Mar03.pdf> (last visited October 14, 2007). However, different authors count reversal statistics somewhat differently. Some authors do not count a reversal if the reversal was based on Rule 36. "All of the other early claim construction studies (the Chu Study (44% reversal rate), the Bender Study (40% reversal rate), and the Zidel Study (41.5% reversal rate)) omitted Rule 36 cases from their claim construction reversal rate determinations." Kimberly A. Moore, "Markman Eight Years Later: Is Claim Construction More Predictable?" 9 LEWIS & CLARK L. REV. 231, 235-236 (2005) (citations omitted)).

⁴ Michael A. O'Shea, *A Changing Role For The Markman Hearing: In Light Of Festo Ix, Markman Hearings Could Become M-F-G Hearings Which Are Longer, More Complex And Ripe For Appeal*, 37 CREIGHTON L. REV. 843, 2004.

⁵ *LizardTech, Inc. v. Earth Res. Mapping, Inc.*, 433 F.3d 1373, 1381, (Fed. Cir. 2006) (Circuit Judge Rader dissenting).

⁶ 35 U.S.C. § 112 (1) et. seq.

⁷ An early invocation of possession as relating to 35 U.S.C. § 112 (1) was *Application of Smith*, 481 F.2d 910 (C.C.P.A., 1973). ("[An] important purpose of § 112, first paragraph ... is the definition of the attributes which a patent specification must possess as of the filing date to be entitled to that filing date as a prima facie date of invention.") *Id.* at 914 (emphasis added).

⁸ DeAnn Foran Smith, *Evolving Issues In The Written Description Requirement*, in PREPARING PATENT LEGAL OPINIONS 2006, (2006).

⁹ *JVW Enters., Inc. v. Interact Accessories, Inc.*, 424 F.3d 1324 (Fed. Cir. 2005).

¹⁰ *LizardTech v. Earth Resource Mapping*, 424 F.3d 1336 (Fed. Cir. 2005).

¹¹ *Id.* at 1378.

applicable to the written description and claim construction. Section II discusses the factual and legal issues of the *JVW* and *LizardTech* cases. Section III discusses Circuit Judge Rader's rationale for the "Evolving Written Description Doctrine" and the role the judicial doctrine of possession has to the "Evolving Written Description Doctrine." Section IV concludes with commentary from the viewpoint of a practitioner examining the roles that Congress and the Federal Circuit have in promulgating the statutory requirements of 35 U.S.C. § 112 and the interpretative judicial doctrines.

II. INTRODUCTION AND BACKGROUND

A. Introduction and Role of the Written Description

1. The Statutory Basis for a Written Description

A patent application is a written document crafted to meet the legal requirements of a specification and drawings for an invention.¹² The United States Patent and Trademark Office ("Patent Office") reviews patent applications according to Patent Law under 35 U.S.C. § 1, et. seq., the Patent Rules, 37 C.F.R. § 1, et. seq., and the Manual for Patent Examining Procedures, a detailed guide written for examiners by the Patent Office.¹³ A drawing is often helpful to describe an invention, but pictures can show only so much. Thus, patent law requires that the specification describe the invention in writing, rather than by pictures alone.¹⁴ The patent rules also require drawings that show every feature of the invention specified in the claims.¹⁵ Only on rare occasions is a drawing sufficient to support an otherwise imprecise patent application.¹⁶

2. Describing the Invention

"A patentee has the right to be his own lexicographer."¹⁷ This phrase dates

¹² 35 U.S.C. § 111(a) (2006).

¹³ "The patent law is Title 35 of the United States Code which governs all cases in the U.S. P.T.O." *Introduction*, Manual of Patent Examining Procedures (Patent and Trademark Office (8th ed. rev 6 2007)). The U.S. P.T.O. may "establish regulations ... for the conduct of proceedings in the U.S. P.T.O." 35 U.S.C. § 2. "[I]n the Code of Federal Regulations the rules pertaining to patents are in Parts 1, 3, 4, 5, and 10 of Title 37." *Id.* "This Manual is published to provide ... patent examiners, applicants, attorneys, agents, and representatives of applicants with a reference work on the practices and procedures relative to the prosecution of patent applications before the USPTO." *Forward*, Manual of Patent Examining Procedures (8th ed. rev. 6 2007).

¹⁴ 37 C.F.R. § 1.153(a) (2000).

¹⁵ 37 C.F.R. § 1.83(a) (2000).

¹⁶ *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1564 (Fed. Cir. 1991) (reversing invalidity for reliance on drawing and remanded to determine the sufficiency of the drawing to §112.). *See also*, Lance Leonard Barry, *A Picture is Worth a Thousand Words: Vas-Cath, Inc. v. Mahurkar*, 76 J. OF PAT. & TRADEMARK OFF. SOC'Y 5 (1994).

¹⁷ *Esnault-Pelterie v. United States*, 81 Ct.Cl. 785, * (1935) *Publication page references are not available for this document. The United States Court of Claims preceded the Court of Customs and

back several decades as a judicial doctrine allowing a patentee to use words of the patentee's own choosing to describe the invention in the specification, even if the meaning contradicts the ordinary meaning.¹⁸ Even so, patent practice is not as flexible. The patent rules require the specification to include a brief and detailed written description with drawings.¹⁹ Patent law requires the specification conclude with the claims.²⁰ Furthermore, the specification must describe the invention "in such full, clear, concise, and exact terms, to enable any person skilled in the art . . . to make and use [the invention,] . . . and shall set forth the best mode."²¹ These clauses describe the definiteness requirement, the enablement requirement and the best mode requirement, respectively. Together they serve as notice to the public of the claimed invention.²² Additionally, these clauses as a whole must meet the adequacy requirement of the specification.²³

The Person Having Ordinary Skill In The Art, often abbreviated by the letters, PHOSITA, is someone with practical experience in the field of the invention. In some fields, such a person might have practical on-the-job training, while other fields may require many years of academic and technical training.²⁴ Lastly, the claims must "particularly point . . . out and distinctly claim . . . the subject matter which the applicant regards as his invention."²⁵

3. Preventing "New Matter" From Being Claimed

The patent laws and rules also include several express requirements regarding prosecution. For instance, a patentee can rely on information in prior inventions and filed documents for the enablement requirement.²⁶ A patentee may also rely on "incorporation by reference" for information of previously filed applications.²⁷ The "no new matter" requirement of 35 U.S.C. § 132 limits incorporation by reference to documents known before the initial filing.²⁸ As such, the last sentence of 35 U.S.C. § 132 expressly restricts this requirement to

Patent Appeals in hearing patent appeals, with appellate division of the former and the latter court now merged into the Court of Appeals for the Federal Circuit. For a brief history of patent law and the courts, see www.ladas.com/Patents/USPatentHistory.html and www.federalcircuithistoricalsociety.org/historyofcourt.html.

¹⁸ *Hormone Research Found., Inc. v. Genentech, Inc.* 904 F.2d 1558, 1563 (Fed. Cir. 1990).

¹⁹ 37 C.F.R. § 1.77 (2005).

²⁰ 35 U.S.C. § 112 para. 2 (2006).

²¹ 35 U.S.C. § 112 para. 1 (2006).

²² *All Dental Prodx, LLC v. Advantage Dental Prods., Inc.* 309 F.3d 774, 779-780 (Fed. Cir. 2002).

²³ *Pandrol USA, LP v. Airboss Ry. Prods, Inc.*, 424 F.3d 1161, 1165 (Fed. Cir. 2005) (citing 35 U.S.C. § 112 para. 1 (1994)).

²⁴ *Kistler Instrumente AG v. United States*, 1979 WL 16488, at 15 (Ct.Cl. Trial Div. 1979).

²⁵ 35 U.S.C. § 112, para. 2 (2006).

²⁶ The specification includes a section called "Background of the Invention" for discussing prior inventions, which are called "prior art." 37 C.F.R. § 1.77. A patent application does not have to educate the person having ordinary skill in the art since such a person is presumed to have "all relevant prior art before him." See *Donaldson Co., Inc. v. Pneumafil Corp.*, 617 F. Supp. 1428, 1433 (D.C.N.C. 1985), *aff'd and vacated in part as moot*, 824 F.2d 979 (Fed. Cir. 1987).

²⁷ 37 C.F.R. § 1.57 (2004).

²⁸ 35 U.S.C. § 132(a) (2006).

amendments, *i.e.*, documents filed during prosecution.²⁹ The no new matter requirement also applies to documents filed before or with the application where the application relies on a patent application that did not issue until after the filing date, and were therefore unknown to a person skilled in the art at the time of filing.³⁰

B. Introduction to the Claim

1. A Brief History of Claims

Patent law instruction, like most modern legal instruction programs, omits historical considerations as such information is usually not legally significant. In the context of patent doctrine, a brief history of the patent claim helps explain the policy behind the doctrine.

The . . . Patent Act of 1793 did not require claims, but did require, in its 3d section, that the patent applicant “deliver a written description of his invention, and of the manner of using, or process of compounding, the same, in such full, clear and exact terms, as to distinguish the same from all things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound and use the same. . .” [The] view of this language [was] that the specification of a patent had two objects. [F]irst . . . “to enable artizans to make and use [the invention] False [and] second . . . to put the public in possession of what the party claims as his own invention” [It] guard[s] against prejudice or injury from the use of an invention which the party may otherwise innocently suppose not to be patented. It is, therefore, for the purpose of warning an innocent . . . person using a machine, of his infringement of the patent; and at the same time, of taking from the inventor the means of . . . pretending that his invention is more than what it really is. [That is] . . . the patentee is required to distinguish his invention in his specification.³¹

In fact, “[c]laim practice did not achieve statutory recognition until the passage of the Act of July 4, 1836, and inclusion of a claim did not become a statutory requirement until 1870.”³² As the discussion below shows, even while discussing the meaning of the claims, the basis of much of the subsequent case law focused on the discussion of the invention rather than the claims. Thus, the next one hundred years did not bring about many seminal claim related cases. One outfall of this focus on the written description is that at least one influential patent law text shows about one-third of all seminal patent cases date from after 1970, and particularly since 1996.³³

²⁹ *Id.*

³⁰ *In re Glass*, 492 F.2d 1228, 1232 (C.C.P.A. 1974) (disallowing certain patent applications filed before the patent at issue, on grounds that the patents did not issue until after the filing date, and were therefore not known to a person skilled in the art at the time of filing).

³¹ *Vas-Cath Inc.*, 935 F.2d at 1560-61 (citing *Evans v. Eaton*, 20 U.S. 356, 430-433 (1822)).

³² *Markman*, 517 U.S. at 379 (citations omitted).

³³ The reader is directed to the highlighted cases in the Table of Cases (pp. xxvii-xliii) of CRAIG ALAN NARD ET AL., *PRINCIPLES OF PATENT LAW*, (2d ed. 2001).

2. *Markman: Claim Construction as a Matter of Law*

One of the difficulties in a patent case is deciding what the inventor considered as the invention at the time of filing the application. The judicial process of determining the meaning of the claims is “claim construction.” The technology is at times difficult for the lawyers to understand and even more so for the court. Juries struggled for years with claim construction until the U.S. Supreme Court held in *Markman* that claim construction was a question of law rather than a factual question for the jury.³⁴ Decided now by the court as a matter of law, the judicial process of claim construction is a *Markman* hearing. The importance of the *Markman* case is both its question of law ruling and its rationale. The Court stated in *Markman* that claim construction, as a matter of law, is important for uniformity in patent cases.³⁵

The Court’s premise was that, “treating interpretive issues as purely legal will promote . . . intrajurisdictional certainty through the application of stare decisis on those questions not yet subject to interjurisdictional uniformity under the authority of the single appeals court.”³⁶

As the Court noted, this was the same rationale used by Congress for creating the Court of Appeals for the Federal Circuit.³⁷ To this goal, the Court’s rationale was to ensure a proposed definition fully comports with the specification and claims, and avoids leaving evidentiary questions of meaning wide open in every new court in which a patent might be litigated.³⁸

3. *The Fine Art of Claim Construction*

Claim construction must begin with the words of the claims themselves.³⁹ The court will first view the claims in the ordinary and customary meaning of a person having skill in the art at the time of invention.⁴⁰ Complicating claim construction is that the format of the claims usually prevents an explanation in the claims of their meaning. This format often requires reliance on the written description.⁴¹ Both claim construction and the adequacy requirement focus on the skill of an ordinary person in the art to understand the written description.⁴² Thus, claim construction depends on the field of art and the context of the patent.⁴³

³⁴ *Markman*, 517 U.S. at 391.

³⁵ *Id.* at 390.

³⁶ *Id.* at 391.

³⁷ *Id.* at 390.

³⁸ *Id.* at 390-91.

³⁹ *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 457 F.3d 1293, 1301 (Fed. Cir. 2006).

⁴⁰ *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005).

⁴¹ *Id.*

⁴² *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576 (Fed. Cir. 1996).

⁴³ *Medrad, Inc. v. MRI Devices Corp.*, 401 F.3d 1313, 1318 (Fed. Cir. 2005).

4. *Role of the Specification to Claim Construction*

While claim construction is a question of law,⁴⁴ patent “compliance with the written description requirement is a question of fact”⁴⁵ that “depends on what is claimed and what is described.”⁴⁶ To have valid claims to different forms of the invention, the patentee must expressly claim the invention with terms that provide the broadest interpretation of invention. This makes claim construction more art than science as the court often must infer what the patentee attempts to define as the invention. The Court of Appeals for the Federal Circuit has clearly stated that each claim construction case is particular to the patent at issue rather than to judicial decisions on claim construction as a whole.⁴⁷ Thus, the Court of Appeals for the Federal Circuit cautions against reading too much into claim construction from one patent to another.⁴⁸

If the specification is not clear enough, other sources are available. On the intrinsic side, the court may use the prosecution history, if any.⁴⁹ If the claims are still ambiguous the court may then use dictionaries and extrinsic evidence such as treatises, and finally, expert testimony.⁵⁰ Expert testimony might be used to show equivalence at the time of invention, or the time of the alleged infringement.⁵¹ The basic rule being whether a person having skill in the art of amusement rides would know of the equivalence of the claimed and accused inventions.⁵²

C. *Patent Claims at Modern Law*

1. *Enablement*

a. *The Statutory Role*

As an express component of the patent statutes, enablement was not, by that term, a hotly debated issue until recently. During the first one hundred years of patent law after claims became a statutory requirement, courts created the lexicographer doctrine⁵³ and the prohibition against undue experimentation, which led to the non-obviousness doctrine, which became a statutory requirement in

⁴⁴ *Markman*, 517 U.S. at 391.

⁴⁵ *Pandrol USA, LP v. Airboss Ry. Products, Inc.*, 424 F.3d 1161, 1164 (Fed. Cir. 2005).

⁴⁶ *LizardTech*, 433 F.3d at 1375.

⁴⁷ *Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448, 1662 (Fed. Cir. 1998) (Plager, J., concurring).

⁴⁸ *Medrad*, 401 F.3d at 1318.

⁴⁹ *Vitronics*, 90 F.3d at 1582.

⁵⁰ *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 457 F.3d 1293, 1301 (Fed. Cir. 2006) (quoting *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1116 (Fed. Cir. 2004)).

⁵¹ *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 608, 70 S.Ct. 854 (1950); *Warner-Jenkinson v. Hilton-Davis*, 520 U.S. 17, 29, 40, 117 S.Ct. 1040 (1997).

⁵² *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 609, 70 S.Ct. 854 (1950).

⁵³ *Esnault-Pelterie v. United States*, 81 Ct.Cl. 785 (1935).

1952.⁵⁴ Interestingly, these two judicial doctrines laid the foundation for the present-day controversy.⁵⁵

Even without judicial interpretation, the enablement requirement seems plain enough.

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.⁵⁶

As the applicable role of the judiciary is statutory interpretation, the patent bar looks to the courts for useful clarification.⁵⁷ In fact, the leading case on enablement stated enablement as a simple requirement. “The specification contains a written description of the invention[,] which must be clear and complete enough to enable those of ordinary skill in the art to make and use it.”⁵⁸

b. The Judicial Role

The history of the expressions, “full, clear, concise, and exact terms,” and “to enable any person skilled in the art” shows that the written description requirement of 35 U.S.C. § 112 has not been an easy interpretation.⁵⁹ For example, “any person skilled in the art” in the statute becomes “those of ordinary skill in the art” in judicial doctrine.⁶⁰ Furthermore, “to enable any person skilled in the art” means “without requiring undue experimentation.”⁶¹ In the most succinct of explanations available, the Court of Appeals for the Federal Circuit summarized the requirement by saying, “the first paragraph requires that the specification describe the invention set forth in the claims.”⁶²

2. Definiteness

Despite the focus on the written description, in infringement litigation, “the name of the game is the claim.”⁶³ While paragraph one of 35 U.S.C. § 112 requires “full, clear, concise, and exact terms of the specification as a whole,” the second paragraph of 35 U.S.C. § 112 requires that the claim shall “particularly point[] out

⁵⁴ 35 U.S.C. § 103 (2006).

⁵⁵ A careful delineation of case law reveals that the lexicographer doctrine led to the *Markman* holding, with the undue experimentation prohibition leading to non-obviousness test and the possession test.

⁵⁶ 35 U.S.C. § 112 para. 1 (2006).

⁵⁷ *Marbury v. Madison*, 5 U.S. 137, 177 (1803).

⁵⁸ *Vitronics*, 90 F.3d at 1582.

⁵⁹ 35 U.S.C. § 112 (2006).

⁶⁰ *Id.*; see also *Vitronics*, 90 F.3d at 1582.

⁶¹ *Invitrogen Corp. v. Clontech Laboratories, Inc.*, 429 F.3d 1052, 1070 (Fed. Cir. 2005); 35 U.S.C. § 112 (2006).

⁶² *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005).

⁶³ *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998) (Clevenger, J., quoting Judge Giles Sutherland Rich, *Extent of Protection and Interpretation of Claims--American Perspectives*, 21 INT'L REV. INDUS. PROP. & COPYRIGHT L. 497, 499 (1990)).

and distinctly claim[] the subject matter which the applicant regards as his invention.”⁶⁴ Thus, the claims are what determine the scope of the patent, not the rest of the specification.

Unfortunately, the Patent Office requires that a claim shall be only a single sentence describing the invention.⁶⁵ Consequently, a claim is often a long run-on sentence that is contrary to the proper rules of grammar and makes claim interpretation much like reading an engineering technical manual.⁶⁶ Providentially, each patent is limited to describing a single invention, and each claim is limited to describing a single embodiment of the invention.⁶⁷

3. *Best Mode*

The best mode requirement looks at three factors. First, the specification must disclose the most useful form of the invention.⁶⁸ Second, the knowledge and belief of the inventor must be the basis for this form.⁶⁹ The third factor looks at the first two factors as of the filing date.⁷⁰

4. *The Judicial Doctrine of Possession*

a. Supporting the Written Description

Possession is not a statutory requirement, but a judicial doctrine.⁷¹ As noted above, an early patent case described possession from the viewpoint of the public. “[A] patent had two objects, . . . first. . . ‘to enable artisans to make and use [the

⁶⁴ An important distinction is that the statutory basis for the claims is 35 U.S.C. § 112(2) (2006).

⁶⁵ Manual of Patent Examining Procedures § 608.01(m) (8th ed. rev 6 2007).

⁶⁶ *Fressola v. Manbeck*, 1995 WL 656874 (D.D.C., 1995) (Challenging Manual of Patent Examining Procedures § 608.01(m) on grounds that the “one-sentence requirement bears no reasonable relationship to the language of and policies behind 35 U.S.C. § 112.” *Id.* at 1. Denied on grounds, “the one-sentence rule fits much more comfortably into the “procedural” box than the “substantive” one.” *Id.* at 4.)

⁶⁷ Manual of Patent Examining Procedures §806.03 (8th ed. rev 3 2006).

⁶⁸ *Great N. Corp. v. Henry Molded Prods., Inc.*, 94 F.3d 1569 (Fed. Cir. 1996) (holding that the inventor cannot disclose one embodiment of the invention and refrain from disclosing the best mode for commercialization).

⁶⁹ *Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1049-52 (Fed.Cir. 1995) (holding that the knowledge of the assignee is not imputed to the inventor).

⁷⁰ *W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1557 (Fed. Cir. 1983) (holding that the best mode requirement applies to the inventor's knowledge as of the filing date). *See also* *Transco Products Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 556-559 (Fed. Cir. 1994) (holding the relevant date for evaluating a best mode disclosure in continuation practice is the date of the parent application and citing *Dow Chemical Co. v. American Cyanamid Co.*, 615 F.Supp. 471, 482, 229 U.S.P.Q. 171, 179 (E.D. La. 1985), *aff'd*, 816 F.2d 617 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 849 (1987) (holding the appropriate date for determining compliance with the best mode requirement for a reissue application is the filing date of the original application and not that of the reissue application)).

⁷¹ “The courts have described the essential question to be addressed in a description requirement issue in a variety of ways.” Manual of Patent Examining Procedures §2163.02 (8th ed. rev 5 2006). “[T]o satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed.” *Id.* (citing *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991)).

invention]’False [and] second . . . ‘to put the public in possession of what the party claims as his own invention.’”⁷²

Then, in 1991, possession took on another meaning. In *Vas-Cath*, the Court of Appeals for the Federal Circuit tried to argue a dichotomy in the court over the roles of enablement and the written description with this statement. “[T]he applicant must . . . convey *with reasonable clarity* to those *skilled in the art* that, as of *the filing date* sought, he or she was in possession of the invention.”⁷³

In doing so, the court seemingly created a new doctrine that required, as of the filing date, the applicant (*i.e.*, the application) used “reasonable clarity,” to inform the person having ordinary “skill in the art,” of the invention.⁷⁴ The problem here is that the enablement requirement requires that the written description is clear and complete enough to enable those of ordinary skill in the art to make and use it.⁷⁵ By including the phrases, “with reasonable clarity,” and “skilled in the art” with the word possession, the Court of Appeals for the Federal Circuit created a new doctrine (test) of possession without answering the question of how enablement relates to the written description.⁷⁶ Focused still on the confusion over enablement and the written description, the court sought to clarify the matter. “There appears to be some confusion in our decisions concerning the extent to which the ‘written description’ requirement is separate and distinct from the enablement requirement. *The purpose of the written description requirement of section 112, first paragraph is to state what is needed to fulfill the enablement criteria.*”⁷⁷ While perceiving the confusion as between enablement and the written description, the court added a new doctrine of possession for supporting the written description requirement.

With uncertainty still reigning several years later, the court again attempted to make a distinction. “[T]here is no question that . . . written description and enablement are separate statutory requirements, and that written description is not simply a facet of enablement.”⁷⁸ Not only did the court not clarify the requirements of written description and enablement, the court again failed to define what it meant by possession. Fortunately, a review of applicable case law shows that there are three facets to possession. These are the filing date, the scope of enablement, and predictably of the art.

b. The Filing Date

Patent applications often rely on earlier applications to take advantage of the earlier filing date to pre-date prior art.⁷⁹ Such instances also occur in division or

⁷² *Vas-Cath*, 935 F.2d at 1560-61 (citing *Evans*, 20 U.S. at 430-33 (1822)).

⁷³ *Id.* at 1563-64 (emphasis added).

⁷⁴ *Id.*

⁷⁵ 35 U.S.C. § 112 para. 1 (2006).

⁷⁶ *Vas-Cath*, 935 F.2d at 1563-64.

⁷⁷ *Vas-Cath*, 935 F.2d at 1563 (emphasis added).

⁷⁸ *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1327 (Fed. Cir. 2003) (Bryson, J., concurring).

⁷⁹ Application of John P. Glass, 492 F.2d 1228, 1233 (C.C.P.A. 1974) (possession applied to growth of crystals seeking earlier filed patent applications as enabling art). *Tronzo v. Biomet, Inc.*, 156

continuation practice,⁸⁰ interference practice⁸¹ or in ex parte challenges where the patentee added the claim at issue subsequent to the application.⁸² Such practice is also common in the filing of provisional applications and in applications seeking the benefit of foreign filed applications in what is called a 'right of priority'.⁸³ As such, the first facet of possession looks to whether at the *filing date* of an *earlier document*, the earlier document adequately instructs persons ordinarily skilled in the art to understand the later claimed invention in the *later filed application*.⁸⁴

c. Scope of Enablement

The scope of enablement facet of possession is likely what contributed to the confusion with the enablement requirement. The scope of enablement delineates whether what the inventor later claims as invented (*i.e.*, in litigation) is a defined embodiment of the disclosure, claims and prosecution history.⁸⁵ By scope of enablement, possession means a claim may not be vague or read as broader than the supporting disclosure.⁸⁶

In *Enzo Biochem*, the court looked at whether the written description on the activity levels of the claimed nucleotides supported the claimed bacteria detection inventions.⁸⁷ While the written description reported in an activity level of greater than five, some of the claims had much higher activity levels, and other claims referred to the inventions *Enzo Biochem* had deposited with a public organization.⁸⁸ In a case of first impression, the court stated that "the mere appearance of vague claim language in an original claim or as part of the specification [does not] necessarily satisf[y] the written description requirement or show[] possession of a generic invention."⁸⁹ At least for the then new field of

F.3d 1154, 1158 (Fed. Cir. 1998) (possession applied to surgical technique seeking earlier filing date of the parent application).

⁸⁰ Division practice refers to the splitting of one application containing two or more inventions into multiple applications. 35 U.S.C. § 121 (2006). Continuation practice refers to the filing of an application to supplant an earlier application. 37 C.F.R. § 1.114 (2007).

⁸¹ *Bilstad v. Wakalopoulos*, 386 F.3d 1116, 1123 (Fed. Cir. 2004) (citing *Eiselstein v. Frank*, 52 F.3d 1035, 1039 (Fed. Cir. 1995)).

⁸² *Enzo Biochem. Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 969 (Fed. Cir. 2002) (Lourie, J., concurring).

⁸³ 35 U.S.C. §§ 119, 120 (2006).

⁸⁴ *Application of Edwards*, 568 F.2d 1349, 1351 (C.C.P.A. 1978) (Reversing a rejection for inadequacy on grounds that an earlier application relied on as a reference did not provide an adequate descriptive for the make and use requirement of 25 U.S.C. § 112 para. 1). Said another way: "[T]hat requirement evidences appreciation of an important purpose of § 112, first paragraph, which is the definition of the attributes which a patent specification must possess as of the filing date to be entitled to that filing date as a prima facie date of invention." *Application of Smith*, 481 F.2d 910, 914 (C.C.P.A. 1973) (holding that the how-to-use requirement was satisfied where there was no basis upon which to question use of all polymers within claimed genus, and where scope of genus was commensurate with specification disclosure).

⁸⁵ *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1476 (Fed. Cir. 1998) (citing *Markman*, 52 F.3d at 979-81 (en banc), *aff'd*, 517 U.S. 370 (1996)).

⁸⁶ *Id.* at 1473 (holding the location of controls as limited to the console as "[n]o similar variation beyond the console is even suggested").

⁸⁷ *Enzo Biochem*, 285 F.3d at 960-62.

⁸⁸ *Enzo Biochem*, 285 F.3d at 962.

⁸⁹ *Enzo Biochem*, 285 F.3d at 972 (holding that "reference in the specification to a deposit in a

genetic engineering, the court held that "[i]nventions that cannot reasonably be enabled by a description in written form in the specification, but that otherwise meet the requirements for patent protection, may be described in surrogate form by a deposit that is incorporated by reference into the specification."⁹⁰

In *Enzo Biochem*, the Court of Appeals for the Federal Circuit effectively upheld the possession requirement in a case that did not involve priority.⁹¹ In a harbinger of the 2005-2006 cases discussed below, the *Enzo Biochem* dissent questioned the court's decision not to hear the case en banc, as well as the court's use of the possession test.⁹²

d. Predictability of the Art

The last facet of possession is whether the written description adequately discusses the claims for a person having skill in the art to understand all details of all embodiments in sufficient detail without undue experimentation, what the Court of Appeals for the Federal Circuit has called "predictability of the relevant art."⁹³ In fact, the Court of Appeals for Federal Circuit has applied the possession doctrine almost exclusively to the complex, high-technology cases in the fields of material science, chemistry and biology, where the state of the art is rapidly changing.⁹⁴ In these fields, a broadly-defined invention called the genus includes one or more narrowly-broadly defined inventions called the species.⁹⁵ Such inventions are common in genetic engineering.⁹⁶

Predictability looks beyond the written description to the knowledge of the person having skill in the field of science. This allows a patentee to rely on the knowledge of peers to understand how to make and use the invention.⁹⁷ In this respect, the patentee can focus on the invention while expending less effort and

public depository, which makes its contents accessible to the public when it is not otherwise available in written form, constitutes an adequate description of the deposited material sufficient to comply with the written description requirement of § 112, para. 1", and denying a petition for en banc rehearing) (emphasis added).

⁹⁰ *Enzo Biochem*, 285 F.3d at 966.

⁹¹ *Id.* at 960.

⁹² *Id.* at 988 (Linn, J., dissenting).

⁹³ *Plant Genetic Systems, N.V. v. DeKalb Genetics Corp.*, 315 F.3d 1335, 1340 (Fed. Cir. 2003) (citing *In re Vaeck*, 947 F.2d 488, 495 (Fed. Cir.1991)).

⁹⁴ 1970's - Chemistry: Application of Smith, 481 F.2d 910 (C.C.P.A., 1973) (cationically active "living" polymers). Application of John P. Glass, 492 F.2d 1228 (C.C.P.A. 1974) (growth of crystals). 1990's - Material science in surgical devices: *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555 (Fed. Cir. 1991) and *Tronzo v. Biomet, Inc.*, 156 F.3d 1154 (Fed. Cir. 1998). *Capon v. Eshhar*, 418 F.3d 1349 (Fed. Cir. 2005) (genetic inventions).

⁹⁵ *Enzo Biochem*, 323 F.3d at 966-67. See e.g., *Genus-Species* Manual of Patent Examining Procedures § 715.03, *Markush Claims* Manual of Patent Examining Procedures § 803.02, and *Standard for Determining Compliance With the Written Description Requirement*, Manual of Patent Examining Procedures § 2163.02 (8th ed. rev 6 2007).

⁹⁶ *Capon v. Eshhar*, 418 F.3d 1349, 1357 (Fed. Cir. 2005) (possession applied to genetic engineering). See also *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (The application at issue was titled, "Hybrid Genes Incorporating a DNA Fragment Containing a Gene Coding for an Insecticidal Protein, Plasmids, Transformed Cyanobacteria Expressing Such Protein and Method for Use as a Biocontrol Agent").

⁹⁷ *Chiron Corp. v. Genentech, Inc.*, 363 F.3d 1247, 1253 (Fed. Cir. 2004) (citing *AK Steel Corp. v. Sollac*, 344 F.3d 1234, 1244 (Fed. Cir. 2003)).

funds documenting the knowledge of the person having ordinary skill in the art.⁹⁸ For example, in *Bilstad v. Wakalopulos*, Bilstead's application related to an "apparatus for sterilizing three-dimensional objects using ionizing radiation without affecting the target objects in a deleterious manner."⁹⁹ At issue was whether the patent application had to "describe every embodiment within the range of two to infinity to support the count."¹⁰⁰ The Court of Appeals for the Federal Circuit found that the Board of Patent Appeals and Interferences had not considered: "[W]hether [the] disclosure of manipulation in a small number of directions would reasonably convey to a person skilled in the relevant art that Bilstad had possession of manipulation in a plurality of directions as of his filing date."¹⁰¹

The Court of Appeals for the Federal Circuit therefore vacated the judgment of the Board of Patent Appeals and Interferences and remanded for further proceedings.¹⁰² The court's rationale was that not every specification needs the complete detail of every embodiment in the specification.¹⁰³ This view does not apply to genetic engineering, where a description of a single species is insufficient for a claim to the genus, or for a description of the genus to claim the species, without a description of the species in the specification.¹⁰⁴

Practitioners should note that while the possession test is not codified in law or through the rules, the Patent Office is including it in its examiner training under the "Guidelines for Examination of Patent Applications under 35 U.S.C. 112, paragraph 1, Written Description Requirement."

The purpose of the written description analysis is to confirm that applicant had possession of what is claimed. The Guidelines . . . instruct the examiner to look for consistency between a claim and what provides adequate factual support for the claim as judged by one of ordinary skill in the art from reading the corresponding written description.¹⁰⁵

To assure the reader that the possession versus enablement confusion is still not yet corrected, the Patent Office provides this clarification: "The written description requirement, a question of fact, ensures that the inventor conveys to others that he or she had possession of the claimed invention; whereas, the enablement requirement, a question of law, ensures that the inventor conveys to

⁹⁸ Whether billed by the hour or by the page, patent applications are time consuming and usually long. Applicants often file Information Disclosure Statements to separately provide that state of the art knowledge. On a related, but opposite side of the patenting coin is the Winslow test for obviousness. "[P]icture the inventor as working in his shop with the prior art references – which he is presumed to know – hanging on the walls around him." *In re Winslow*, 365 F.2d 1017, 1021 (CCPA 1966) (Rich, J.)

⁹⁹ *Bilstad*, 386 F.3d at 1118.

¹⁰⁰ *Id.* at 1123.

¹⁰¹ *Id.* at 1126.

¹⁰² *Id.* at 1127.

¹⁰³ *Id.* at 1123-24 (citing *In re Smythe*, 480 F.2d 1376, 1382 (C.C.P.A. 1973)).

¹⁰⁴ *Regents of the Univ. of California v. Eli Lilly & Co.*, 119 F.3d 1559, 1567 (Fed. Cir. 1997).

¹⁰⁵ 66 Fed. Reg. 1099, 1100 at Comment (1), U.S. Dept. of Comm., U.S.P.T.O. (2001) (emphasis added). See also Manual of Patent Examining Procedures §2163 (8th ed. rev. 6 (2007)).

others how to make and use the claimed invention.”¹⁰⁶

In all, perhaps the best explanation this author found is still from the 2003 Amgen Court:

The purpose of the written description requirement is to prevent an applicant from later asserting that he invented that which he did not; the applicant for a patent is therefore required to “recount his invention in such detail that his future claims can be determined to be encompassed within his original creation.”¹⁰⁷

While this is not the last word on the possession test in this article, the discussion of the evolution of the possession test is sufficient to introduce the Evolving Written Description Doctrine.

III. THE BACKGROUND CASES

A. Introduction to the Evolving Written Description Doctrine

In January 2006, Circuit Judge Rader dissented in the rehearing denial of *LizardTech, Inc. v. Earth Resource Mapping, Inc.*, with an admonishment of the Court of Appeals for the Federal Circuit for making what were, in his view, two contradictory rulings.¹⁰⁸ In October 2005, a panel of the court had held in *JVW Enterprises, Inc. v. Interact Accessories, Inc.*,¹⁰⁹ that the claims can be broadly read to include an embodiment even if the embodiment is not expressly supported by the specification.¹¹⁰ The next day, a panel of different judges held in *LizardTech* that a claim is invalidated if all elements are not supported by the specification.¹¹¹ On appeal by *LizardTech* for a re-hearing, the en banc court affirmed.¹¹² In dissent to the en banc decision, Circuit Judge Rader called the court to task for allowing the *JVW* patentee to assert an embodiment the specification did not describe, while the court invalidated a claim that prevented the *LizardTech* patentee from doing the same thing.¹¹³ Circuit Judge Rader called this apparent inconsistency the “evolving written description doctrine.”¹¹⁴ A minimally technical review is warranted as the art and facts of these cases are sufficiently different to affect the arguments.

¹⁰⁶ 66 Fed. Reg. 1099, 1100 at Comment (4), U.S. Dept. of Comm., U.S.P.T.O. (2001). *See also* Manual of Patent Examining Procedures §2163 (8th ed. rev. 6 (2007)).

¹⁰⁷ *Amgen Inc. v. Hoechst Marion Rousse, Inc.*, 1314 F.3d 1313, 1330 (Fed. Cir. 2003) (citing *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1561 (Fed. Cir. 1991)).

¹⁰⁸ *LizardTech*, 433 F.3d at 1376.

¹⁰⁹ *JVW Enterprises, Inc. v. Interact Accessories, Inc.*, 424 F.3d 1324 (Fed. Cir. 2005).

¹¹⁰ *LizardTech*, 433 F.3d at 1376.

¹¹¹ *LizardTech*, 424 F.3d at 1336.

¹¹² *LizardTech*, 433 F.3d at 1376.

¹¹³ *Id.* at 1377.

¹¹⁴ *Id.* at 1377.

B. *JVW and the Imported Function Doctrine*

1. *The Patent at Issue: U.S. 4,494,754*

JVW owns United States Patent No. 4,494,754¹¹⁵ for an I-beam shaped device used for holding a video game controller.¹¹⁶ The invention relieves the user from having to manually hold the game controller during play. The patent claims an upper horizontal platform to hold the game controller that includes a “means for lockably receiving a video game controller in fixed position” on a mounting member.¹¹⁷ The patent claims both the video game controller holder, and ways of using the video game controller holder.¹¹⁸ While there are several drawings in the patent, every drawing shows the invention holding the same Atari joystick controller with the embodiments differing by how the user sat with the invention.

2. *Claim Construction and the District Court Ruling*

a. Claim Construction

JVW sued Interact, a video game device manufacturer, for infringement by the Interact V3 and V4 steering wheel video game controllers.¹¹⁹ One point of contention in this case is that the patent shows an external holder for a video game controller, while the accused devices *are* video game controllers.¹²⁰ In the patent, the “means” shown “for lockably receiving a video game controller in fixed position” are four flexible L-shaped clips outside the video game controller shown in the drawing.¹²¹ In its claim construction ruling, the district court considered this arrangement of the clips and the controller a necessary “interlace,” but acknowledged that the game controller was not part of the invention.¹²²

¹¹⁵ Apparatus For Playing Home Video Game, U.S. Patent No. 4,494,754 (issued Jan. 2, 1985).

¹¹⁶ U.S. Patent No. 4,494,754, Fig. 1 and 2..

¹¹⁷ U.S. Patent No. 4,494,754, Col. 4. ll. 1-2 and ll. 33-35. “Mounting member” refers to the upper flat portion of the I-shaped invention. This is a classic “means-plus-function” claim under 35 U.S.C. § 112, para. 6 (2006). The claim must describe a function of the invention, and provide an element in the invention to perform that function.

¹¹⁸ Independent claims 1 and 5 provided different embodiments for the user to kneel or sit on the lower horizontal platform. U.S. Patent No. 4,494,754, Col. 3. ll. 47-48 (Claim 1), and Col. 4 ll. 27-29 (Claim 5), and Col. 3, ll. 17-27 (describing Figures 4, 5 and 6.) Any use of the patented invention without a license is an infringement of the invention, 35 U.S.C. § 271 (2006). One goal of a patent is to provide as many variations of the invention as possible to provide protection for different uses. Claims for making or using an invention are best suited where the invention is not patentable for some reason. The issue in JVW is ironic in that the patent provides fewer embodiments of the invention holding the game controller than how the user is positioned for holding the invention.

¹¹⁹ *JVW Enters.*, 424 F.3d at 1327.

¹²⁰ See Figure 1 below for a side by side comparison.

¹²¹ U.S. Patent No. 4,494,754, figs. 2 and 3, col. 2, ll. 39-45, col. 3. l. 50 col. 4. l. 2, and col. 4. ll. 33-35.

¹²² *JVW Enters.*, 424 F.3d at 1328 (citing *JVW Enters., Inc. v. Interact Accessories, Inc.*, No. 00-CV-1867 (D. Md. May 9, 2002) (“Supplemental Memorandum and Order Re Patent Claim Construction”). There is disagreement in the patent bar, and on the bench, whether the accused product has a role in claim construction. Some courts perform claim construction ‘blind’ to the features of the

In the Interact models, the allegedly infringing clips are inside the housing of the video game controller.¹²³ For JVW to succeed in its infringement action, JVW would have to prove that the Interact models infringe the patent by using identical or similar clips and that whether the clips were inside or outside the housing is irrelevant.¹²⁴

Another claim construction issue was the district court's interpretation of "in fixed position" and "means for lockably receiving" to require the invention to lock and unlock the controller in position.¹²⁵ The specification lacked an express statement of how to remove the controller so the district court viewed the clips as immovable unless removed.¹²⁶ In addition, the district court interpreted the pronounced horizontal portions of the L-clips as restraining the controller vertically as well as from side to side.¹²⁷

b. Holding by the District Court

One aspect that distinguishes the V3 and V4 video game controllers are the separable shells that move the clips away from the steering wheel to unlock and adjust the video game controller.¹²⁸ Since this made the clips movable, the district court held there was no infringement as the V3 and V4 video game controllers lacked the interlace structure and the immovable function of the patented device.¹²⁹

3. Errors by the District Court

On appeal by JVW, the Court of Appeals for the Federal Circuit (2005) agreed that the "means for lockably receiving" claim was a valid means plus function claim.¹³⁰ The court held though, that the district court's claim construction violated two rules of means plus function interpretation.¹³¹ First, "a court may not construe a means-plus-function limitation 'by adopting a function

accused product.

¹²³ *Id.* at 1327 ("The V3 utilizes plastic clips mounted inside a shell that surrounds a steering wheel column.").

¹²⁴ *Markman*, 517 U.S. at 374 ("Victory in an infringement suit requires a finding that the patent claim 'covers the alleged infringer's product or process.'"); *JVW Enters.*, 424 F.3d at 1333 ("The fact that the V3 adds a shell to allow the steering wheel height to be adjusted and a cam mechanism to provide a mechanical way to tighten and loosen the clips does not mean that the clips do not lock the steering wheel in a fixed position.").

¹²⁵ *JVW Enters.*, 424 F.3d at 1328 (citing *JVW Enters., Inc. v. Interact Accessories, Inc.*, No. 00-CV-1867 (D, Md. Feb. 1, 2002) ("Memorandum and Order Re Patent Claim Construction")).

¹²⁶ *JVW Enters.*, 424 F.3d at 1329.

¹²⁷ Figures 1, 2 and 3 show controller holders 21-24 in the same L-shape pattern and same 4-side configuration. This is the only, and stated, preferred embodiment of the invention. U.S. Patent No. 4,494,754, col. 3, ll. 28-36.

¹²⁸ *JVW Enters.*, 424 F.3d at 1329.

¹²⁹ *Id.* at 1329.

¹³⁰ *Id.* at 1329 ("The parties agree, as do we, that 'means for lockably receiving a video game controller in fixed position on said mounting member' is a means-plus-function limitation recognized by 35 U.S.C. § 112, ¶ 6."). A means plus function claim allows a patentee to claim multiple embodiments through a specific format. 35 U.S.C. § 112 para. 6 (2006).

¹³¹ "The first construction violated two tenets governing the determination of function in a means-plus-function limitation." *Id.* at 1331.

different from that explicitly recited in the claim.”¹³² The court found that the district court had confused the separate functions of “fixed position” and “lockably receiving.” The claims do not require the invention to both hold in place and unlock the video game controller.¹³³ Thus, the district court erred in finding an interlacing of parts to lock and unlock the controller.¹³⁴

The second rule is that a court may not “import[] the functions of a working device into the . . . specific claims,” but must “read[] the claims for their meaning independent of any working embodiment.”¹³⁵ The court found that the district court had read into the claims a function for the L-shaped controller holders to “lock a controller into a fixed position by preventing linear, up and down movement of the [controller].”¹³⁶ However, the claimed function is only to “lockably receiv[e] a video game controller in fixed position,” without regard to the direction of how the clips kept the controller from moving.¹³⁷ The limitations imbued by the district court were merely functions of the separate structural elements present in the preferred embodiment¹³⁸ to facilitate the claimed function to “lockably receiv[e] a video game controller in fixed position.”¹³⁹ Since these were not claimed functions, the district court erred in requiring them. The invention merely has to lock the controller in place, irrespective of the direction of limited motion.¹⁴⁰

4. *Infringement Analysis*

With a crucial exception, the Interact V3 and V4 video game controllers are quite alike. The V3 has L-shaped clips that surround the steering wheel column while the V4 has a donut shaped plate. The Court of Appeals for the Federal Circuit (2005) found that the L-shaped clips on the accused V3 product performed the same function and were identical or equivalent to the L-shaped clips of the patent, and thus, the V3 model infringed the patent.¹⁴¹

With its donut-shaped plates surrounding the metal shaft, the V4 locks the controller from rotational motion rather than locking the controller from horizontal and vertical motion.¹⁴² Thus, the V4 did not infringe the patent as “the structures clearly perform the claimed function in substantially different ways.”¹⁴³

Interact argued for non-infringement on grounds that the video game

¹³² *JVW Enters.*, 424 F.3d at 1331 (citing *Micro Chem., Inc. v. Great Plains Chem. Co.*, 194 F.3d 1250, 1258 (Fed. Cir. 1999)).

¹³³ *JVW Enters.*, 424 F.3d at 1331 (“[I]n its first construction the district court impermissibly added unclaimed functional limitations of “unlocking” and “releasing” the video game controller.”).

¹³⁴ *Id.* at 1330.

¹³⁵ *Id.* at 1331 (citing *Rodime PLC v. Seagate Tech., Inc.*, 174 F.3d 1294, 1303 (Fed. Cir. 1999)).

¹³⁶ *JVW Enters.*, 424 F.3d at 1335.

¹³⁷ U.S. Patent No. 4,494,754 col. 3 l. 50-col. 4 l. 2, col. 4 ll. 33-35.

¹³⁸ U.S. Patent No. 4,494,754 col. 3 ll. 28-36.

¹³⁹ U.S. Patent No. 4,494,754 col. 3 l. 50, col. 4 l.2, col. 4 ll. 33-35.

¹⁴⁰ *JVW Enters.*, 424 F.3d at 1331.

¹⁴¹ *JVW Enters.*, 424 F.3d at 1333.

¹⁴² *Id.* at 1335.

¹⁴³ *Id.* at 1335 (citing *Odetics, Inc. v. Storage Tech. Corp.*, 185 F.3d 1259, 1267 (Fed. Cir. 1999)).

controllers are not intended “for playing a video game without any additional accessory,” while the only embodiment shown in the patent is a holder of video game controllers.¹⁴⁴ The court disagreed, saying it “would be improper” to “import limitations into claims from . . . embodiments appearing only in a patent’s written description . . . unless the specification makes clear that “the patentee . . . intends for the claims and the embodiments in the specification to be strictly coextensive.”¹⁴⁵

The court opined that “after reviewing the specification, we conclude that the patentee did not intend for the claims and the embodiments disclosed in the specification to be coextensive.”¹⁴⁶ This meant the court was willing to accept a broad view of the claims even though the written description did not support such a view because the patent did not express the narrow view argued by Interact. The reader may note the court reversed the district court’s construction for interlacing and directionally applied locking for the same reason.¹⁴⁷ While the opinion did not expressly state to what part of the specification the court was referring to, this author believes the court merely compared Figure 5 to the Interact video game controllers. This author prepared such a comparison, which is Figure 1 below this section. The reader will likely note the striking similarities.

5. Discussion and Summary on *JVW*

There are two problems with the court’s decision. For one, the holding of infringement by the V3 ignores that the court went inside the V3 to find the infringing L-clips. Logically, a video game controller cannot infringe a device intended to hold the video game controller. This is analogous to looking inside the Atari controller shown in the drawings and finding infringement. This is the prior art-infringement dichotomy of “that which infringes if later, would anticipate if earlier.”¹⁴⁸ As such, the court could have affirmed the district court holding of non-infringement, and invalidated the patent as anticipated by the Atari controller.¹⁴⁹

The second problem is the court’s finding of the V3 as infringing, but the V4 as not infringing. The court described the patented invention as one which “the player may sit or kneel on the base of the accessory with his or her legs on either side of the riser,” [with] “the controller [] held in place by the controller holders and stabilized using the player’s weight.”¹⁵⁰ As noted above, the court apparently saw the striking similarity of the V3 to the *JVW* patented invention. As a matter of law, the finding of infringement is consistent with the purpose of the means-plus-function limitation and the doctrine of equivalents to prevent such subversion of

¹⁴⁴ *Id.* at 1335.

¹⁴⁵ *Id.*; see also *Phillips*, 415 F.3d at 1323 (en banc).

¹⁴⁶ *Id.* at 1335.

¹⁴⁷ *Id.* at 1331 (citing *Rodime PLC v. Seagate Tech., Inc.*, 174 F.3d 1294, 1303 (Fed. Cir. 1999)).

¹⁴⁸ *Peters v. Active Mfg. Co.*, 129 U.S. 530, 537 (1889).

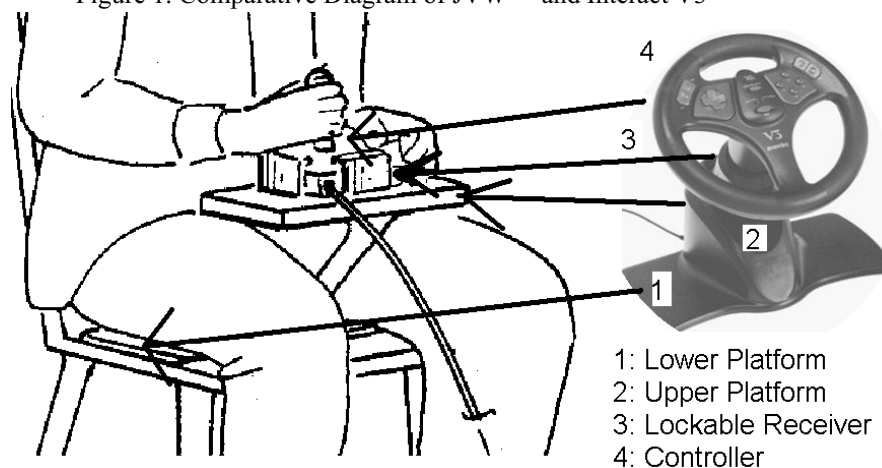
¹⁴⁹ We can only speculate what might have happened had the same panel judges as *LizardTech* made the decision.

¹⁵⁰ *JVW Enters.*, 424 F.3d at 1327 (citing U.S. Patent No. 4,494,754 col.3 ll.13-28, col.1 ll.42- 47).

patented ideas by insubstantial differences.¹⁵¹ A finding of non-infringement by the V3 would allow the wholesale copying of patented devices.

The finding of non-infringement for the V4 model is somewhat perplexing. The two models are identical except for the ability of the V4 to “lock a controller into a fixed position by preventing rotational movement of the steering wheel unit on the shaft.”¹⁵² The JVW patent does not claim a limitation to only “lock a controller into a fixed position by preventing linear, up and down movement of the steering wheel column.”¹⁵³ This is the limitation of the preferred embodiment L-clips, shown for “lockably receiving [an Atari] video game controller in fixed position.”¹⁵⁴ The court said that the district court erred by imputing a strict locking function of the L-clips to the patented invention.¹⁵⁵ Yet, the court distinguished the linear locking function of the patented invention as justifying non-infringement by the V4.¹⁵⁶ If the court can see through the distinction that Interact copied the whole of the JVW patented device for the V3, why did the court not see that the donut-shaped plates of the V4 were merely a means for “lockably receiving [the Interact V4] video game controller in fixed position?”¹⁵⁷

Figure 1. Comparative Diagram of JVW¹⁵⁸ and Interact V3¹⁵⁹



U.S. Patent No. 4,494,754 figure 5 compared the Interact V3 (Image ©Amazon.com)

¹⁵¹ *Id.* at 1333 (citing *Odetics*, 185 F.3d at 1267).

¹⁵² *Id.* at 1335.

¹⁵³ *Id.* at 1335.

¹⁵⁴ U.S. Patent No. 4,494,754 col. 4 ll. 1-2.

¹⁵⁵ *JVW Enters.*, 424 F.3d at 1335. For purposes of 35 U.S.C. § 112 (2006), the drawings are part of the written description. In other regards, the drawings are t rules make a separate requirement. 35 U.S.C. § 111(a)(2) (2006).

¹⁵⁶ *Id.*

¹⁵⁷ *Id.*

¹⁵⁸ U.S. Patent No. 4,494,754 fig. 5.

¹⁵⁹ Image (http://ec1.images-amazon.com/images/P/B00000JDDY.01_SS500_SCLZZZZZZZ_.gif) available at <http://www.amazon.com/Interact-SV280-V3-Racing-Wheel/dp/B00000JDDY> (last visited Mar. 18, 2007).

*C. LizardTech And The Possession Test*¹⁶⁰

1. The Patent At Issue: U.S. Patent No. 5,710,835

LizardTech, Inc. is the exclusive licensee of U.S. Patent No. 5,710,835 (issued January 20, 1998) for use of a set of mathematical formulas in software, called Digital Wavelet Transform algorithms, which compress digital images without creating fuzzy edges.¹⁶¹ If the reader were to look at the software code that makes a digital image, the reader would find many rows and columns of digital data, as if looking at a giant Sudoku puzzle.¹⁶² The LizardTech patented method mathematically divided the image into a mosaic of digital tiles before running the non-patented software algorithms.¹⁶³ LizardTech alleged infringement by the competing Earth Resource Mapping (ERM) method ("ER Mapper"), which ran each individual row and column of digital data through the non-patented software algorithms.¹⁶⁴

*2. Claim Construction Issues*¹⁶⁵

The parties litigated the patent through two hearings and three appeals without going to trial.¹⁶⁶ The first hearing related to claim construction of the term "tile" as used in the patent.¹⁶⁷ The district court (in 2000) held that the LizardTech tile method did not include the single pixel row method used by ERM and granted summary judgment to ERM for non-infringement.¹⁶⁸ On appeal by LizardTech (in 2002), the Court of Appeals for the Federal Circuit reversed this claim construction, and rejected alternative arguments by ERM that the terms "selected sequence" and "maintaining updated sums" excluded the ER Mapper method.¹⁶⁹

Even so, the appeal ruling did not help Lizardtech. On remand, the district

¹⁶⁰ *LizardTech*, 424 F.3d at 1336.

¹⁶¹ *Id.* at 1337.

¹⁶² The district court case (cited *infra*) as well as *Deposition of Stuart Nixon* provide a brief discussion of the technology. *LizardTech v. Earth Resource Mapping*, 2000 WL 34502412 (W.D. Wash. 2000). The interested reader will find references of varying complexity, including *Apparatus for image manipulation*, Everett Truman Eiselen, U.S. Patent 3,976,982 (issued Aug. 24, 1976). The patent at issue provides a more state of the art discussion. Samples and explanations of Sudoku are online at many sites. <http://en.wikipedia.org/wiki/Sudoku> (last visited Oct. 20, 2007).

¹⁶³ *LizardTech v. Earth Resource Mapping*, 2000 WL 35453681 at 1 (W.D. Wash. 2000). The reader can simulate the tiling method by marking a grid, such as a 3x3 tic-tac-toe grid, over a picture.

¹⁶⁴ *Id.* A digital image is like a mosaic, but made of dots on the computer screen, called pixels, rather than of small pictures. The reader can verify this by using the zoom tool of most image-viewing software to step progressively upwards through the zoom factors. At some point, the image will become fuzzy with solid squares of color.

¹⁶⁵ For clarity, words such as "information," "data," "process" or "method" replace various technical terms and phrases from the patent and the proceedings that are not significant to the patent principles on which this discussion focuses.

¹⁶⁶ *LizardTech*, 2000 WL 35453681 at 1 (W.D. Wash. 2000).

¹⁶⁷ *Id.* at 3.

¹⁶⁸ *LizardTech*, 2000 WL 35453681.

¹⁶⁹ *LizardTech*, 35 Fed. Appx. 918 (Fed. Cir. 2002).

court (2004) construed “seamless” such that the ER Mapper method did not follow the same steps as the patented method.¹⁷⁰ Additionally, the district court construed that the terms “overlapping” and “maintaining updated sums” excluded the ER Mapper method.¹⁷¹ Thus, “the district court held on summary judgment that ERM did not infringe claims 1 and 13 of the ‘835 patent.”¹⁷²

3. *Invalidation for Lacking Possession*

Claims 1 and 21 were very similar, and would have been identical, except that claim 21 lacked the terms, “maintaining updated sums,” “periodically compressing said sums” and “seamless.”¹⁷³ This difference in the claims is acceptable as long as the claims can be read to refer to different inventions, *i.e.*, claim 21 cannot be the same invention as claim 1.

Thus, the district court viewed claim 21 as referring to a non-seamless process.¹⁷⁴ The district court also viewed the written description as explaining the workings of a seamless process, but not explaining a non-seamless process.¹⁷⁵ The court held that a person having ordinary skill in the art would not understand how to make and use the non-seamless invention.¹⁷⁶ For this reason, the district court held claim 21 and its dependent claims as indefinite and invalid.¹⁷⁷

On appeal (2005), LizardTech had a two-fold problem. One problem was that LizardTech could not argue that claim 21 impliedly included all three missing elements, as then claim 21 would be the same as claim 1 and still invalid. To avoid this interpretation, LizardTech argued that based on the entire specification, an ordinary person skilled in the art would understand that the seamless process applied also to claim 21.¹⁷⁸ Citing the prosecution history, the Court of Appeals for the Federal Circuit (2005) agreed with LizardTech.¹⁷⁹

There still remained the problem of claim 21 lacking the elements of “maintaining updated sums” and “periodically compressing said sums.”¹⁸⁰ For claim 21 to be valid, LizardTech had to show the claim could be read to perform a seamless process without use of “maintaining updated sums,” and “periodically compressing said sums.”¹⁸¹ The next step is looking to the patent for such “full, clear, concise, and exact terms as to enable any person skilled in the art,” how to

¹⁷⁰ *LizardTech*, 424 F.3d at 1339, 1340-41 (2005). The remand opinion is *LizardTech, Inc. v. Earth Res. Mapping, Inc.*, 2004 WL 34502412 (W.D.Wash. March 14, 2004).

¹⁷¹ *Id.* at 1342-43. *See also, Vitronics*, 90 F.3d at 1582 (holding that a patentee cannot construe a term to have different meanings in different claims) (citing *Hoescht Celanese Corp. v. BP Chem. Ltd.*, 78 F.3d 1575, 1578 (Fed. Cir.), *cert. denied*, 117 S.Ct. 275 (1996).

¹⁷² *Id.* at 1340-41.

¹⁷³ *Id.* at 1343 (citing U.S. Patent No. 5,710,835).

¹⁷⁴ *Id.*

¹⁷⁵ *Id.*

¹⁷⁶ *LizardTech*, 424 F.3d at 1343.

¹⁷⁷ *LizardTech*, 424 F.3d at 1343.

¹⁷⁸ *Id.* at 1343.

¹⁷⁹ *Id.* *See e.g., Phillips*, 415 F.3d at 1315 (en banc).

¹⁸⁰ *LizardTech*, 424 F.3d at 1343.

¹⁸¹ *Id.* at 1344.

make and use the invention.¹⁸² There, the court found a problem. The "specification provides only a single way of creating a seamless [process], which is by maintaining updated sums. There is no evidence that the specification contemplates a more generic way of creating a seamless [process]."¹⁸³

As this point, the court had clear precedent to invalidate claim 21 based on the §112(1) enablement clause.¹⁸⁴ The court showed this understanding in two ways. For one, the court cited another enablement case that proved its point.¹⁸⁵ Second, the court reiterated enablement as the reason for invalidation. "After reading the patent, a person of skill in the art would not understand how to make a seamless [process] generically and *would not understand LizardTech to have invented a method for making a seamless [process], except by 'maintaining updating sums.'*"¹⁸⁶

Instead, the court oddly diverged into the best mode requirement, mixed in the enablement clause and invoked an old quid pro quo case.¹⁸⁷ As though to justify this mix, the court then once again linked the enablement clause to the possession doctrine. "Those two requirements usually rise and fall together. [A] recitation of how to make and use the invention across the full breadth of the claim is ordinarily sufficient to demonstrate that *the inventor possesses the full scope of the invention*, and vice versa."¹⁸⁸

As noted above, the possession test has previously been held only to complex, high-technology subject matter in the material science, chemistry and biological arts.¹⁸⁹ Here, the court held the possession test to a software patent, which has not before been subjected to the possession test. In addition, with apparent knowledge and disregard, the court resurrected the pre-*Vas-Cath* enablement-possession confusion.¹⁹⁰

Whether the flaw in the specification is regarded as a *failure to demonstrate that the patentee possessed the full scope* of the invention recited in claim 21 or a *failure to enable the full breadth of that claim*, the specification provides inadequate support for the claim under section 112, paragraph one.

This statement suffers three problems. First, the court failed to keep written description and enablement separate as stated by the *Moba* court.¹⁹¹ Second, the court failed to provide an interpretation of the judicial and statutory policies the

¹⁸² *Id* (citing 35 U.S.C. § 112 (2006)).

¹⁸³ *LizardTech*, 424 F.3d at 1344.

¹⁸⁴ The written description shall provide "the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art ... to make and use the same." 35 U.S.C. § 112, para. 1 (2006).

¹⁸⁵ *LizardTech*, 424 F.3d at 1345 (citing *AK Steel Corp. v. Sollac & Ugine*, 344 F.3d 1234, 1244 (Fed. Cir. 2003)).

¹⁸⁶ *LizardTech*, 424 F.3d at 1345 (emphasis added).

¹⁸⁷ *LizardTech*, 424 F.3d at 1344.

¹⁸⁸ *LizardTech*, 424 F.3d at 1345 (emphasis added).

¹⁸⁹ *See supra* *Predictability of the Art*, Part I.C.4.

¹⁹⁰ *LizardTech*, 424 F.3d at 1345 (emphasis added).

¹⁹¹ *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1327 (Fed. Cir. 2003) (Bryson, J., concurring).

court was attempting to invoke with the possession doctrine. Lastly, in citing the missing claim element as the cause of invalidity, the court failed to recognize it was invoking the requirement that the claims shall “particularly point[] out and distinctly claim[] the subject matter which the applicant regards as his invention.”¹⁹² Presuming that what the court said is true, in prosecution, such a claim would fail the definiteness requirement of 35 U.S.C. § 112 paragraph 2 and the enablement requirement of 35 U.S.C. § 112 paragraph 1. Such unsupported claims are called omnibus claims because “it is indefinite in that it fails to point out what is included or excluded by the claim language.”¹⁹³

The seminal case for omnibus claims is *O’Reilly v. Morse*.¹⁹⁴ Morse had invented the telegraph and sued O’Reilly for infringement of Morse’s eighth claim, which stated:

I do not propose to limit myself to the specific machinery or parts of machinery described in the foregoing specification and claims; the essence of my invention being the use of the motive power of the electric or galvanic current, which I call electro-magnetism, however developed, for making or printing intelligible characters, signs or letters, at any distances, being a new application of that power, of which I claim to be the first inventor or discoverer.¹⁹⁵

As here, omnibus claims attempt to provide patent coverage for related inventions that the inventor has not invented. As Morse claimed, “I do not propose to limit [my invention to the] specifications and claims.”¹⁹⁶ At that time though, claims were a relatively new addition to patents. Even so, Chief Justice Taney recognized that “this claim can derive no aid from the specification filed. It is outside of it, and the patentee claims beyond it.”¹⁹⁷ Thus, the U.S. Supreme Court invalidated the claim.¹⁹⁸ The *LizardTech* court recognized the similarity of the situation in citing Morse.¹⁹⁹

Adopting *LizardTech*’s argument “would lead to sweeping, overbroad claims because it would entitle an inventor to a claim scope far greater than what a person of skill in the art would understand the inventor to possess or what a person of skill in the art would be enabled to make and use.

So clearly, the court understood that claim 21 was invalid, either by failure of the enablement clause of 35 U.S.C. § 112 paragraph 1, or the definiteness clause of paragraph 2. Consequently, the court’s citing of the possession test here is perplexing.²⁰⁰

¹⁹² 35 U.S.C. § 112 para. 2 (2006).

¹⁹³ *Omnibus Claim*, Manual of Patent Examining Procedures §2173.05(r) (8th ed. rev 6 2007), (citing Ex parte Fressola, 27 USPQ2d 1608 (Bd. Pat. App. & Inter. 1993).

¹⁹⁴ *O’Reilly v. Morse*, 56 U.S. 62 (1853).

¹⁹⁵ *Id.*

¹⁹⁶ *Id.*

¹⁹⁷ *O’Reilly*, 56 U.S. at 119-20.

¹⁹⁸ *Id.* at 136-37.

¹⁹⁹ *LizardTech*, 424 F.3d at 1346.

²⁰⁰ *LizardTech*, 424 F.3d at 1345.

4. *Per Curiam Denial of Rehearing*

LizardTech petitioned for a re-hearing by the court or an en banc appeal.²⁰¹ The court (2006) denied the petition as did the circuit judges polled for an en banc appeal.²⁰² Circuit Judge Lourie wrote a concurring opinion, while Circuit Judge Rader dissented. In the concurrence, Circuit Judge Lourie raised eight arguments in support of the petition denial. These were:²⁰³

- (a) Case law has been consistent upholding 35 U.S.C. § 112;
- (b) That quid pro quo required a full disclosure;
- (c) The disclosure failed to meet the full disclosure requirements;
- (d) The facts here are different than in other cases;
- (e) The disclosure failed the possession test (without calling it that);
- (f) The preferred embodiment did not support the claim;
- (g) 35 U.S.C. §132 bars new matter and that 35 U.S.C. §112 does not so apply, and
- (h) The court has at least twice declined to hear a written description case en banc.

As discussed below, these arguments implicate that the Court of Appeals for the Federal Circuit is both improperly invoking the possession test, and raising the standard for showing possession. Due to the expansiveness of judicial doctrine in the opinion, this article will discuss each argument separately.

5. *Concurring Opinion and Counterarguments*

a. Does Judicial Doctrine Rule Over the Statute?

The concurrence purportedly supported the invalidation of claim 21. Instead, it served to show that the Court of Appeals for the Federal Circuit is divisive in the interpretation of 35 U.S.C. § 112. First, Circuit Judge Lourie opened his arguments with judicial doctrine. “Our case law has been quite consistent in holding that the patent law requires that a patent contain a written description of a claimed invention independent of the requirements to enable one skilled in the art to make and use the invention.”²⁰⁴

Second, Circuit Judge Lourie argues that there is by “statute, policy, and practice,” “a written description [requirement] . . . independent of the requirement [] to enable one skilled in the art to make and use the invention.”²⁰⁵ As support, Circuit Judge Lourie quotes the first paragraph of 35 U.S.C. § 112, with emphasis on the “and” between the written description requirement in the statute, and the enablement clause.²⁰⁶ Circuit Judge Lourie adds two instances of comporting case

²⁰¹ *LizardTech*, 433 F.3d at 1374 (denying en banc rehearing).

²⁰² *Id.*

²⁰³ *LizardTech*, 433 F.3d at 1374-76 (Lourie, J., concurring).

²⁰⁴ *LizardTech*, 433 F.3d at 1374 (Lourie, J., concurring).

²⁰⁵ *Id.*

²⁰⁶ *Id.*

law.²⁰⁷

However, this first set of arguments suffers from two problems. The first problem is the choice of order in the arguments. First, rather than citing the statute, Circuit Judge Lourie cites judicial doctrine (“[o]ur case law has been quite consistent”), as though judicial doctrine on written description had overruled the statute, which as yet the court has not done.²⁰⁸ In *Marbury*, the U.S. Supreme Court said the role of the judiciary is interpretation, thus the first argument is the statute, not judicial doctrine.²⁰⁹ Second, these arguments are irrelevant. The statutory requirements for enablement, best mode and definiteness are not challenged here, nor have they been recently challenged. In this case, and the other cases cited here, the parties were not challenging the statutes, but rather the judicial interpretation of the statute.

b. Applying Quid Pro Quo to the Written Description

Circuit Judge Lourie then cited the quid pro quo doctrine, saying it is self-evident public policy applied to the entirety of the written description.

The whole purpose of a patent specification is to disclose one’s invention to the public. It is the *quid pro quo* for the grant of the period of exclusivity. The need to tell the public what the invention is, in addition to how to make and use it, is self-evident. One should not be able to obtain a patent on what one has not disclosed to the public.²¹⁰

This argument is subject to challenge on multiple fronts. The first challenge is that quid pro quo as applied to patent law does not involve 35 U.S.C. §112, but rather the legitimate use of the patent. The first use of quid pro quo arose from the 1836 patent law that “authorized the extension of a patent, on the application of the executor or administrator of a deceased patentee.”²¹¹ However, a licensee of the patent could not use the extension.²¹² While the law disappeared, the doctrine did not. The U.S. Supreme Court later cited the doctrine as justification for the “exclusive right” exception to monopoly and antitrust law giving a patentee a limited licensing right without violating the Sherman Antitrust Act (15 U.S.C. §1, et. seq.).²¹³ These cases present the quid pro quo doctrine as a use doctrine, not a patentability doctrine.

This view is supported by a 1974 case in which the U.S. Supreme Court had to determine whether federal preemption applies to state laws that protect unpatentable trade secrets much as patent law would protect them, if they were

²⁰⁷ *LizardTech*, 433 F.3d at 1374-75 (Lourie, J., concurring) (citing *Invitrogen Corp. v. Clontech Labs., Inc.*, 429 F.3d 1052, 1071 n. 17 (Fed.Cir. 2005), and *Capon v. Eshhar*, 418 F.3d 1349, 1360 (Fed.Cir. 2005)).

²⁰⁸ *LizardTech*, 433 F.3d at 1374 (Lourie, J., concurring)

²⁰⁹ *Marbury v. Madison*, 5 U.S. 137, 177 (1803).

²¹⁰ *LizardTech*, 433 F.3d at 1375 (Lourie, J., concurring).

²¹¹ *Wilson v. Rousseau*, 45 U.S. 646, 647 (1846).

²¹² *Woodworth v. Sherman*, 30 F. Cas. 586, 589 (Cir. Ct. Mass. 1844) (holding, *inter alia*, that an assignee could not get an extension since the patentee did not have the right to grant the extension).

²¹³ *Simpson v. Union Oil Co. of Cal.*, 377 U.S. 13, 24 (1964) (holding that a consignment license coerced on lessees is illegal under anti-trust laws).

patentable.²¹⁴ In *Kewanee Oil Co. v. Bicron Corp.*, the U.S. Supreme Court recognized that the limited monopoly of patents, *i.e.*, the open use of the patented invention, served as an incentive (the *quid pro quo*) to "full disclosure." "The more difficult objective of the patent law to reconcile with trade secret law is that of disclosure, the *quid pro quo* of the right to exclude."²¹⁵

In *Kewanee*, the U.S. Supreme Court recognized that allowing protection of trade secrets provides the same use incentive to businesses that did not need, qualify for, or could not afford patent protection.²¹⁶ The problem before the Court was how to strike a proper balance between undisclosed, but state protected trade secrets, and disclosed, but federally protected ideas.

[S]tate rules which would grant such incentives seem to conflict with the economic *quid pro quo* underlying patent protection; *i.e.*, a monopoly limited in time, in return for full disclosure of the invention. Thus[,] federal law has struck a balance between incentives for inventors and the public's right to a competitive economy. In this sense, the patent law is an integral part of federal competitive policy.²¹⁷

The difficulty for businesses is that trade secrets can keep a business in business for decades, as with Coca-Cola, which has been a trade secret for some 120 years.²¹⁸ A patent, on the other hand, provides only a limited monopoly for a fraction of that time.²¹⁹ At expiration, everyone can legally make, sell and use the invention with impunity.²²⁰ Thus, by ruling that federal patent law did not preempt the state trade secret law, the *Kewanee* Court affirmed the *quid pro quo* doctrine as a balancing factor in the competitive decisions made by businesses of whether to maintain a trade secret or seek patent protection, without regard to the disclosure of the application.²²¹

Other cases involving patents have also focused on the individual actions of the patentee/assignee in competition, rather than on the disclosure.²²² In *Rite-Hite*

²¹⁴ *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 472 (1974).

²¹⁵ *Id.* at 484 (citing *Universal Oil Co. v. Globe Co.*, 322 U.S. 471, 484 (1944)).

²¹⁶ *Kewanee Oil*, 416 U.S. at 474.

²¹⁷ *Kewanee Oil*, 416 U.S. at 497, n.2 (holding that a state law granting monopoly protection to processes and manufacturing techniques by barring disclosure of unpatentable trade secrets does not violate federal patent law) (quoting Adelman, *Secrecy and Patenting: Some Proposals for Resolving the Conflict*, 1 APLA QUARTERLY JOURNAL 296, 298-99 (1973)).

²¹⁸ See *e.g.*, *The Chronicle Of Coca-Cola*, available at http://www.thecoca-colacompany.com/heritage/chronicle_birth_refreshing_idea.html; or *The History of Coca Cola*, available at http://inventors.about.com/od/cstartinventions/a/coca_cola.htm. (Last visited Oct. 20, 2007).

²¹⁹ A patent grants the patentee "the right to exclude others from [importing into,] making, using, offering for sale, or selling the invention throughout the United States" for a term of 20 years from the earlier of the filing or priority date. 35 U.S.C. § 154(a) (2006).

²²⁰ 35 U.S.C. § 271(a)(1) (2006) (prohibiting the making, using, offering to sell, sale or importing of any patented invention within the United States without authority during the term of the patent).

²²¹ The federal trade secret protection statutes, *i.e.*, 18 U.S.C. § 1831-1839, have been on the books since 1996. Just as with the patent statutes, these statutes do not, and cannot, address the competitive cost-benefit analysis necessary for whether a business should seek a patent or keep the information a trade secret. *Kewanee Oil*, 416 U.S. at 484-491.

²²² See *e.g.* *Image Technical Servs., Inc. v. Eastman Kodak Co.*, 125 F.3d 1195, 1997-02 (9th Cir. 1997) (holding that a monopolist's exclusion of others from its intellectual property by refusing to license or sell its intellectual property is a presumptively valid business justification to exclusionary

(1995), the Court of Appeals for the Federal Circuit placed emphasis of the quid pro quo doctrine on the marketplace, not patentability.²²³ Even the most recent U.S. Supreme Court case has not departed from that role.²²⁴

The second difficulty is that cases that have tied quid pro quo to the written description doctrine have conditioned the link to public use of the invention. In the first case linking quid pro quo to the written description, a district court applied quid pro quo to the best mode requirement of 35 U.S.C. § 112.²²⁵ In *Systematic Tool & Mach. Co.*, the district court said that “disclosure of the best method of performing the task the patent is intended to accomplish [is the] *the quid pro quo* for the grant of a legal monopoly over the subject matter, so that *the public may obtain maximum benefits through* complete revelation by the patentee.”²²⁶ According to the *Systematic* court, the quid pro quo doctrine focuses on the best benefit of the invention, not the enablement (make and use) clauses of §112(1).²²⁷ Unlike *Systematic Tool & Mach. Co.*, *Lizardtech* was not a question of validity under the best mode requirement—which also was not mentioned in the opinion other than in one short reference.²²⁸

Not too long ago, the U.S. Supreme Court looked at the relationship of the quid pro quo doctrine to the written description.²²⁹ In *J. E. M. Ag Supply, Inc. v. Pioneer Hi-Bred International*, the U.S. Supreme Court said that “to obtain a utility patent, a breeder must describe the plant with sufficient specificity to enable others to “make and use” the invention *after the patent term expires*. *The disclosure required by the Patent Act is “the quid pro quo of the right to exclude.”*”²³⁰

There are, however, distinguishing factors between *J. E. M. Ag Supply* and *LizardTech*. First, in *J. E. M. Ag Supply*, the U.S. Supreme Court faced the question of whether newly developed plant breeds are patentable subject matter where Congress provides for utility patents under 35 U.S.C. § 101, plant patents under the Plant Protection Act (35 U.S.C. §§ 161-164) and Plant Variety Certificates under the Plant Variety Protection Act (84 Stat. 1542, as amended, 7 U.S.C. § 2321 et. seq.).²³¹ The patentability question in *LizardTech* was limited

conduct for any immediate harm to consumers).

²²³ *Rite-Hite Corp. v. Kelley Co., Inc.*, 56 F.3d 1538, 1562 (Fed. Cir. 1995) (holding that “[t]he patent system was not designed merely to build up a library of information by disclosure, ... but *[is] to get new products into the marketplace during the period of exclusivity* so that the public receives full benefits from the grant”) (internal citation omitted) (emphasis added).

²²⁴ *Ill. Tool Works Inc. v. Indep. Ink, Inc.*, 547 U.S. 28 (2006) (holding that a patent does not necessarily confer market power upon the patentee and requiring a plaintiff prove a patentee/defendant has market power in the tying product).

²²⁵ The specification shall . . . set forth the best mode contemplated by the inventor of carrying out his invention. 35 U.S.C. § 112(1) (2006).

²²⁶ *Systematic Tool & Mach. Co. v. Walter Kidde & Co., Inc.*, 390 F.Supp. 178, 195-96 (E.D. Pa. 1975) (*rev'd on other grounds*, 555 F.2d 342 (3rd Cir. 1977)) (emphasis added).

²²⁷ *Id.*

²²⁸ *LizardTech*, 424 F.3d at 1344.

²²⁹ *J. E. M. Ag Supply, Inc. v. Pioneer Hi-Bred Int'l, Inc.*, 534 U.S. 124, 127 (2001).

²³⁰ *J. E. M. Ag Supply, Inc. v. Pioneer Hi-Bred Int'l, Inc.*, 534 U.S. 124, 142 (2001) (emphasis added) (citing *Kewanee*, 416 U.S. at 484 (1974) (citing 35 U.S.C. § 112).

²³¹ *Id.* at 127 (holding that newly developed plant breeds are patentable subject matter of § 101, and

strictly to the scope of the disclosure in support of the claims.²³² Second, in most patent cases, the Court uses the broader, and more common term, patentee.²³³ Here, the Court does not refer to a patentee, but to the breeder.²³⁴ Thus, the focus in *J. E. M. Ag Supply* is not on an inventor, but on a person working with live biological materials. In addition, plant inventions are subject to the biological deposit requirement of 37 C.F.R. §§ 1.801-1.809 because of “the practical difficulties of describing unique biological materials in a written description.”²³⁵ A deposit is not required, optional, or even allowed for a software invention.²³⁶

In general, the quid pro quo doctrine is intended to entice a patentee to place the invention in the marketplace with the limited “right to exclude.”²³⁷ The distinguishing factors between *J. E. M. Ag Supply* and *LizardTech* make it clear that applying quid pro quo to the entirety of the written description must be limited to the cases where there are “practical difficulties of describing [the invention] in a written description.”²³⁸ Consequently, application of the quid pro quo doctrine to the possession test is limited to specific subject matter, just as courts in the past have done for genus-species patents.²³⁹

c. Patent Practice

Circuit Judge Lourie then notes that patent applications provide for two parts in the specification describing the invention, a “substantive portion of a patent specification” and “a fuller written description of what the invention is.”²⁴⁰ By substantive portion, Circuit Judge Lourie was referring to the claims, as shown by the statement that “[a] patent specification always begins with a statement like ‘My invention consists of.’”²⁴¹

Circuit Judge Lourie argues, “[n]o one writes a patent application by beginning with statements like ‘I make my invention as follows’ or ‘I use my invention in the following manner.’”²⁴² However, this argument ignores the patent laws and policy with which Circuit Judge Lourie seeks to support the denial of re-

neither the PPA nor the PVPA limits the scope of § 101 coverage).

²³² *LizardTech*, 424 F.3d at 1344-1345.

²³³ See e.g., *Ill. Tool Works v. Indep. Ink*, 547 U.S. 28 (2005), and *eBay Inc v. MercExchange, L.L.C.*, 126 S. Ct. 1837 (2006) *LizardTech*, 424 F. 3d 1344-1345.

²³⁴ *J. E. M. Ag Supply, Inc. v. Pioneer Hi-Bred Int’l, Inc.*, 534 U.S. 124, 142 (2001) (emphasis added) (citing *Kewanee*, 416 U.S. at 484 (1974)).

²³⁵ *Enzo Biochem*, 323 F.3d at 965.

²³⁶ 37 C.F.R. §§ 1.801-1.809 (2001) (limiting deposits to biological materials). The PTO may require a model. 35 U.S.C. § 114 (2007). A model will not otherwise be admitted without approval from the PTO. 37 C.F.R. § 1.91 (2007). A perpetual motion invention is the only other required working model. Manual of Patent Examining Procedures § 608.03 (8th ed. rev 6 (2007)).

²³⁷ *Kewanee Oil*, 416 U.S. at 497.

²³⁸ *Enzo Biochem*, 323 F.3d at 965 (applying quid pro quo to requiring biological deposits when a written description would be inadequate disclosure).

²³⁹ *Enzo Biochem*, 323 F.3d at 966-67. See also, *Genus-Species* Manual of Patent Examining Procedures § 715.03 and *Markush Claims* Manual of Patent Examining Procedures § 803.02 (8th ed. rev 6 (2007)).

²⁴⁰ *LizardTech*, 433 F.3d at 1375 (Lourie, J., concurring).

²⁴¹ *Id.* at 1375 (Lourie, J., concurring). See also 37 C.F.R. § 1.75(e) (2006).

²⁴² *Id.* at 1375 (Lourie, J., concurring).

hearing.²⁴³ While the phrases alluded to by Circuit Judge Lourie are provided for by the enablement clause of 35 U.S.C. § 112, the rules clearly state such a discussion is part of the Brief Description, and the Detailed Description of the Invention parts of the application.²⁴⁴

In addition, no one could use such a phrase in a claim as described by Circuit Judge Lourie because the application would not pass examination. The patent rules expressly prescribe that the preamble use language such as “I claim,” or “we claim,” followed by “consisting of,” “comprising of,” or another comporting phrase.²⁴⁵ The Court of Appeals for the Federal Circuit has held that the patent rules are procedural in nature, and are not substantive for barring a patent for procedural non-compliance.²⁴⁶ While Circuit Judge Lourie is correct in saying that no one uses these phrases, the enablement clause is irrelevant to his argument.²⁴⁷

d. Inconsistencies

Circuit Judge Lourie next seeks to justify the Court’s denial on re-hearing on grounds that the facts here are different from other cases.²⁴⁸ The argument fails as the facts here are just as sufficiently different to not justify the Court’s decision. If anything, applying the possession test to a case involving software is a case of first impression that requires an en banc review.

e. Passing the Opportunity

Circuit Judge Lourie next seemingly bypassed the opportunity to address the fundamental issues of the *LizardTech* (2005) opinion.²⁴⁹ Circuit Judge Lourie first states that the claims “must be interpreted, in light of the written description, but not beyond it, because otherwise they would be interpreted to cover inventions or aspects of an invention that have not been disclosed.”²⁵⁰ Though sounding as an anti-omnibus claim argument, the test is whether the “written description . . . reasonably convey[s] to a person skilled in the art that [the inventor] had possession of the claimed subject matter at the time of filing.”²⁵¹ This is the same rule cited by the *LizardTech* (2005) court.²⁵² The error by the *LizardTech* (2005) court and Circuit Judge Lourie is that “the [court] never truly discussed the

²⁴³ 35 U.S.C. § 112 (2006).

²⁴⁴ *LizardTech*, 433 F.3d at 1375 (Lourie, J., concurring) (the patent rules, specifically 37 C.F.R. §1.77(b) (2006), prescribe the order of the descriptive sections in a patent application).

²⁴⁵ *Form of Claims*, Manual of Patent Examining Procedures § 608.01(m) (8th ed. rev 6 2007). *See also* 37 C.F.R. §1.75(e) (2006).

²⁴⁶ *Fressola v. Manbeck*, 1995 WL 656874 (D.D.C. March 30, 1995) (upholding the one-sentence rule of Manual of Patent Examining Procedures § 608.01(m) (5th ed. 1989)).

²⁴⁷ *LizardTech*, 433 F.3d at 1375 (Lourie, J., concurring).

²⁴⁸ *Id.*

²⁴⁹ *Id.*

²⁵⁰ *Id.*

²⁵¹ *Bilstad*, 386 F.3d 1116, 1125 (holding that the Board of Patent Appeals and Interferences erred in requiring a patent application for an electronic sterilization apparatus to describe every embodiment within the range construction and not recognizing that a person skilled in the art would readily discern that other members of the genus would perform similarly to the disclosed members).

²⁵² *LizardTech*, 424 F.3d at 1345-46 (citing *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995)).

understandings of persons skilled in the art.”²⁵³ The court should have at least remanded for a re-hearing to ascertain the skill in the art instead of repeatedly pointing to the specification.²⁵⁴

This case and the other cited cases here also raise the appropriateness of the possession test to the fields of software and the technology-related electronic arts.²⁵⁵ The Court of Appeals for the Federal Circuit has generally applied the possession test only to the fields of material science, chemistry and the biological arts.²⁵⁶ It is therefore odd that Circuit Judge Lourie alludes that the possession test is inapplicable here while expressly averting a discussion on the possession test on grounds “that [it] is a more complex topic having its own subtleties.”²⁵⁷

This disclaimer creates a problem of precedent. The first cases of the possession test involved patents invoking earlier filed documents or reference material, or were matters such as genus-species claims.²⁵⁸ The *LizardTech* patent does not rely on earlier filed documents or reference material and the image compression algorithm does not involve a genus-species claim.²⁵⁹ Nor is this patent the type of subject matter the Court of Appeals for the Federal Circuit has said applies the possession test.²⁶⁰ Yet, the *LizardTech* (2005) court clearly stated it was relying on the possession test, providing additional grounds for a re-hearing.²⁶¹ By denying a rehearing, the Court of Appeals for the Federal Circuit is doing just what Circuit Judge Lourie stated the court was not doing in *Enzo Biochem*, i.e., “elevat[ing] possession [as] a statutory test of patentability,” or in other words, “lowering the bar” for using the possession test.²⁶²

f. Elucidated Embodiment Test

Circuit Judge Lourie next says that “[c]laims are not necessarily limited to preferred embodiments.”²⁶³ In this, Circuit Judge Lourie is correct. In *Scimed*, the Court of Appeals for the Federal Circuit said that a patentee may rely on, and does not have to disclose, the knowledge of a person having skill in the art for interpretation of the embodiments.²⁶⁴ In addition, the doctrine of equivalence allows a patentee to extend the scope of the embodiments to equivalents known in the art that perform substantially the same function in substantially the same way

²⁵³ *Bilstad*, 386 F.3d at 1125.

²⁵⁴ *LizardTech*, 424 F.3d at 1345-46.

²⁵⁵ *Application of Edwards*, 568 F.2d 1349, 1351 (C.C.P.A. 1978).

²⁵⁶ *See supra*, *Predictability of the Art*, Part I.C.4.

²⁵⁷ *LizardTech*, 433 F.3d at 1375 (Lourie, J., concurring).

²⁵⁸ *Enzo Biochem*, 323 F.3d at 973 (restricting “the ‘possession’ test for circumstances ... in which the inventors showed possession of a species of the invention by reference to a deposit, but may not have described what else within the scope of the claims they had possession of.”) (Lourie, J., concurring).

²⁵⁹ . *See Predictability of the Art*, Part I.C.4.

²⁶⁰ *LizardTech*, 424 F.3d at 1345-46 (Rader, J., dissenting) (citing *Capon v. Eshhar*, 418 F.3d 1349, 1358 (Fed. Cir. 2005), *see also Enzo Biochem*, 323 F.3d at 969).

²⁶¹ *LizardTech*, 424 F.3d at 1345-46.

²⁶² *Enzo Biochem*, 323 F.3d at 973 (Lourie, J., concurring).

²⁶³ *LizardTech*, 433 F.3d at 1375 (Lourie, J., concurring).

²⁶⁴ *Id.* at 1345.

to obtain substantially the same result as the claimed device or process.²⁶⁵ In *Capon*, the court stated, “[t]he ‘written description’ requirement must be applied in the context of the particular invention and the state of the knowledge” in the art.²⁶⁶ The *LizardTech* (2005) court should have looked at both the specification and the state of the knowledge in the art.

The *LizardTech* (2005) court had held that, “[t]here is no evidence that the specification contemplates a more generic way of creating a seamless [process].”²⁶⁷ Circuit Judge Lourie (2006) attempted to validate this decision by saying that “merely calling an embodiment ‘preferred,’ when there are no others, does not entitle one to claims broader than the disclosure.”²⁶⁸ However, neither the *LizardTech* (2005) court nor Circuit Judge Lourie show that the required knowledge for making a seamless process without use of “maintaining updated sums,” and “periodically compressing said sums” was not within the knowledge of a person having skill in the art.²⁶⁹ The court is not allowing the patentee to act as his own lexicographer and draft the application to the scale of complexity in the art.²⁷⁰

The requirement the court should have been looking for is whether “the specification makes clear that the invention does not include a particular feature.”²⁷¹ As noted above, this is possible only by ascertaining the knowledge of the art. The difficulty here, as with *Bilstad*, is that the court did not make clear that the “feature is . . . outside the reach of the claims.”²⁷²

g. No New Matter

Circuit Judge Lourie also attempted to bolster the court’s reliance on the possession test by pointing out that patent law bars new information in a filed application, so 35 U.S.C. § 112 cannot have such a role.²⁷³ The law cited by Circuit Judge Lourie states that “[n]o amendment” shall introduce new matter.”²⁷⁴ Here, however, Circuit Judge Lourie’s appears to add further to the confusion over the role of the possession test. For example, in *Enzo Biochem*, Circuit Judge Lourie correctly noted that an amendment cannot add knowledge to the specification, so the possession test under § 112(1) is proper to assure that all embodiments are fully and properly disclosed as of the filing of the application.²⁷⁵ Priority disputes also involve the test of disclosure to the filing date, and would be another instance

²⁶⁵ *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 608, 70 S.Ct. 854 (1950).

²⁶⁶ *Capon v. Eshhar*, 418 F.3d 1349, 1358 (Fed. Cir. 2005).

²⁶⁷ *LizardTech*, 424 F.3d at 1344.

²⁶⁸ *LizardTech*, 433 F.3d at 1375 (Lourie, J., concurring).

²⁶⁹ *Id.* at 1343.

²⁷⁰ *Id.* at 1345 (citing *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995)).

²⁷¹ *Scimed Life Sys. v. Advanced Cardiovascular Sys.*, 242 F.3d 1337, 1341 (Fed. Cir. 2001).

²⁷² *Id.*

²⁷³ *LizardTech*, 433 F.3d at 1375.

²⁷⁴ 35 U.S.C. § 132 (2006).

²⁷⁵ *Enzo Biochem*, 323 F.3d 956, 973 (Fed. Cir. 2002) (Lourie, J., concurring) (“[T]he proper basis for rejection of a claim amended to recite elements thought to be without support in the original disclosure . . . is § 112, first paragraph, not § 132.”) (citing *In re Rasmussen*, 650 F.2d 1212, 1214-15, 211 USPQ 323, 326 (C.C.P.A.1981)).

where Circuit Judge Lourie’s reliance on the possession test would be proper.²⁷⁶ However, *LizardTech* was about claim construction and neither an amendment nor a priority date was before the court in this case.²⁷⁷ Consequently, Circuit Judge Lourie’s invocation of § 132 here is inapposite.

h. A Non-Action is Not Precedent

Circuit Judge Lourie also argued that “this court has at least twice declined to hear a written description case en banc,” so “there is no reason for our court to hear this case en banc.”²⁷⁸ The purpose of the Court of Appeals for the Federal Circuit is to “strengthen the United States patent system in such a way as to foster technological growth and industrial innovation.”²⁷⁹ *Markman* made claim construction a matter of law for the court, while the Court of Appeals for the Federal Circuit has renounced *stare decisis* for claim construction.²⁸⁰ If the Court of Appeals for the Federal Circuit bars *stare decisis* for the fundamental action of claim construction, it is inapposite to use *stare decisis* as justification for inaction on claim construction.

IV. RISE OF THE EVOLVING WRITTEN DESCRIPTION DOCTRINE

A. Circuit Judge Rader Dissents

1. Circuit Judge Rader’s View on the *JVW* Opinion

At issue with Circuit Judge Rader in *JVW*, as argued in the *LizardTech* dissent, is how the Court of Appeals for the Federal Circuit handled the disparity between the specification and the disputed claim as compared to other holdings.²⁸¹ In *JVW*, the court found infringement by the V3, a video game controller, even though the patent specification for the infringed invention was a *holder* for a video game controller.²⁸²

Circuit Judge Rader was not troubled that the Court of Appeals for the Federal Circuit allowed this broad scope of patent coverage.²⁸³ In fact, Circuit Judge Rader cited several cases (discussed *infra*) allowing broad interpretation of claims.²⁸⁴ What Circuit Judge Rader found troubling with the *JVW* opinion was that the following day another panel of the Court of Appeals for the Federal Circuit issued the *LizardTech* ruling that invalidated, rather than finding infringement of, a

²⁷⁶ *Enzo Biochem*, 323 F.3d 956, 969 (Fed. Cir. 2002).

²⁷⁷ *LizardTech*, 2000 WL 35453681 at 1 (W.D. Wash. 2000).

²⁷⁸ *LizardTech*, 433 F.3d at 1375-76 (Lourie, J., concurring).

²⁷⁹ *Markman*, 517 U.S. at 390 (citing H.R.Rep. No. 97-312, pp. 20 (1981)).

²⁸⁰ *Markman*, 517 U.S. at 372; *Medrad*, 401 F.3d at 1319.

²⁸¹ *LizardTech*, 433 F.3d at 1376 (Rader, J., dissenting).

²⁸² *JVW Enters.*, 424 F.3d at 1335.

²⁸³ *LizardTech*, 433 F.3d at 1377.

²⁸⁴ *Id.* at 1377 (citations omitted).

claim that the *LizardTech* patentee sought to have read broadly.²⁸⁵

2. Comparing the Opinions

The force of Circuit Judge Rader's dissent is immediately apparent.²⁸⁶ "This court's written description jurisprudence has become opaque to the point of obscuring other areas of this court's law."²⁸⁷ As was apparent to Circuit Judge Rader, the *JVW* court validated a claim for a video game controller *holder* to include within its scope a video game *controller*, even though the disclosure did not demonstrate such scope. Conversely, the *LizardTech* (2005) court invalidated a claim because the disclosure did not demonstrate such broad scope.²⁸⁸

In both cases, the claims encompass more than the specification expressly describes." Yet, "[d]espite their similarities, the outcomes in *LizardTech* and *JVW* are strikingly different." "In *JVW*, this court says that a claim scope in excess of the specification's embodiments grants a broader range of infringement," while "[i]n *LizardTech*, this court says that a claim scope in excess of the specification's embodiments invalidates the claim."²⁸⁹

Quoting a trade article, Circuit Judge Rader remarks that these are "[t]wo cases whose juxtaposition presents a puzzle."²⁹⁰ Circuit Judge Rader found particularly exasperating the rationale of the courts in each case: "[I]n *JVW*, this court determines that the claims are properly construed as broader than the disclosed embodiments because 'the patentee did not intend for the claims and the embodiments disclosed in the specification to be coextensive.'"²⁹¹ Meanwhile, "[i]n *LizardTech*, this court invalidates claims that are broader than the disclosed embodiments because '[t]here is no evidence that the specification contemplates a more generic way' of performing the claimed invention."²⁹²

Circuit Judge Rader correctly noted that this inconsistency is not lost as a source of confusion for the patent bar. "[T]hese next-door neighbors in West's Federal Reporter must leave practitioners in a quandary."²⁹³ Acknowledging the true difficulty, Circuit Judge Rader said that in the face of these opinions, the Court of Appeals for the Federal Circuit "provides little or no guidance about the standard it uses to decide" whether a disclosure is adequate under 35 U.S.C. § 112.²⁹⁴

²⁸⁵ *LizardTech*, 242 F.3d at 1346.

²⁸⁶ *LizardTech*, 433 F.3d at 1376-81 (Rader, J., dissenting).

²⁸⁷ *Id.*

²⁸⁸ *LizardTech*, 424 F.3d at 1347.

²⁸⁹ *LizardTech*, 433 F.3d at 1376 (Rader, J., dissenting).

²⁹⁰ *Id.* (quoting John L. Rogitz, *CAFC Happenings*, Intell. Prop. Today, November, 2005, at 32).

²⁹¹ *LizardTech*, 433 F.3d at 1376 (Rader, J., dissenting) (citing *JVW Enters.*, 424 F.3d at 1335).

²⁹² *Id.* (citing *LizardTech*, 424 F.3d at 1344).

²⁹³ *Id.*

²⁹⁴ *Id.* at 1380.

B. The Crooked Path to the Evolving Written Description Doctrine

At this point, the reader might want to step back and look at the claim construction routes taken by both cases. The claim construction in *JVW* was “in light of this court’s recent en banc clarification of claim construction [in *Phillips*],”²⁹⁵ *LizardTech*, on the other hand, was faced with “constru[ing] claim 21 as limited to seamless discrete wavelet transformation . . . despite the absence of the term seamless in that claim,”²⁹⁶ and without “maintaining updated sums,” or “periodically compressing said sums” in the process.²⁹⁷

It is also helpful to recognize that in *JVW*, the *accused infringer* asked that the court read the claim *narrowly* according to the specification *where the patent did not express the disputed scope of claim*.²⁹⁸ Instead, the court declined and held for infringement.²⁹⁹ According to Circuit Judge Rader, this is keeping with the *Phillips* viewpoint. “Phillips clarified claim construction, and in the process discussed the situation of specific embodiments coupled with broad claims: “[A]lthough the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments.”³⁰⁰

Circuit Judge Rader also cited other case law supporting a broader reading of the claim:

[C]laims may embrace ‘different subject matter than is illustrated in the specific embodiments in the specification.’³⁰¹ In particular, we have expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment.³⁰² To avoid importing limitations from the specification into the claims, it is important to keep in mind that the purposes of the specification are to teach and enable those of skill in the art to make and use the invention and to provide a best mode for doing so.³⁰³ Indeed, in *Phillips* itself, this court gave the broad claim term ‘baffle’ a meaning beyond the narrower bullet-deflecting embodiments in the specification.³⁰⁴

In *LizardTech*, on the other hand, the court adopted a disputed claim construction at the argument of the *patentee*.³⁰⁵ Then, the *patentee* suggested that

²⁹⁵ *LizardTech*, 433 F.3d at 1377 (Rader, J., dissenting) (citing *JVW Enters.*, 424 F.3d at 1335) (citing *Phillips*, 415 F.3d at 1323 (en banc)).

²⁹⁶ *Id.* at 1376-77 n.1.

²⁹⁷ *LizardTech*, 424 F.3d at 1343.

²⁹⁸ *JVW Enters.*, 424 F.3d at 1335.

²⁹⁹ *Id.* at 1336.

³⁰⁰ *LizardTech*, 433 F.3d at 1377 (Rader, J., dissenting) (quoting *Phillips*, 415 F.3d at 1326-27).

³⁰¹ *Id.* (quoting *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 906-08 (Fed. Cir. 2004); citing *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1327 (Fed. Cir. 2002); and *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985)).

³⁰² *Id.* (citing *Gemstar-TV Guide v. Int'l Trade Comm'n*, 383 F.3d 1352, 1366 (Fed. Cir. 2004) (citations omitted)).

³⁰³ *Id.* See also *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1533 (Fed. Cir. 1987).

³⁰⁴ *LizardTech*, 433 F.3d at 1377) (Rader, J. dissenting) (citing *Phillips*, 415 F.3d at 1326-27 (en banc)).

³⁰⁵ *LizardTech*, 424 F.3d at 1344.

the court should read the claim *broadly* with less regard to the specification.³⁰⁶ Instead, the court held the claim invalid.³⁰⁷ Thus, the outcome seems dependent on who does the asking. As bizarre as this observation seems to be, Circuit Judge Rader recognized an “unsatisfying solution” of logic to the cases.³⁰⁸ This is the “evolving written description doctrine.”³⁰⁹

If the claims are construed as confined to the embodiments in the specification, written description invalidity does not come into play. If the claims, on the other hand, are construed to embrace more than the specification, this court (on only some occasions and without a clear standard to determine those occasions in advance) will invalidate.³¹⁰

As Circuit Judge Rader commented, the *LizardTech* ruling must leave “[p]atent owners and practitioners. . . [struggling] to resolve the tension between *Phillips* and cases like *LizardTech*.”³¹¹ Certainly, the patentee must have been shocked at the claim invalidation.³¹² On the other hand, although the phrase “evolving written description doctrine” is rather new, this author is of the opinion that the doctrine has been in place for some time.

C. The Link to Possession

In many patent litigation cases, we can assume the accused infringer will want the patent construed within the specification tightened, or invalidated, while the patentee is looking for the broadest scope of claim coverage. Thus, the first sentence of Circuit Judge Rader’s evolving written description doctrine applies to the accused infringer while the second phrase applies to the patentee.³¹³ At the outset then, Circuit Judge Rader’s evolving written description doctrine seems to be a statement in which the outcome seems somewhat dependent on who does the asking.³¹⁴

The next question is that if this is truly a doctrine, what precedents define how the doctrine works? In discussing the dissent initially, Circuit Judge Rader did not mention the possession test by name, but there was no mistaking he was saying that neither patent qualified for such exacting treatment: “[B]oth *LizardTech* and *JVW* confront an issue common to many patent disputes: claims that are broader than the disclosed embodiments. (citations omitted.) Neither opinion involves biotechnology or chemistry, . . . [nor] discusses the issue of complexity or uncertainty in the art, a frequent characteristic of claims invalidated on written

³⁰⁶ *Id.* at 1346.

³⁰⁷ *Id.*

³⁰⁸ *LizardTech*, 433 F.3d at 1376.

³⁰⁹ *Id.* at 1379.

³¹⁰ *Id.* at 1377 n.1.

³¹¹ *Id.* at 1378.

³¹² *Id.* at 1377 n.1.

³¹³ *LizardTech*, 433 F.3d at 1377 n. 1.

³¹⁴ The accused infringer would want the invention “confined to the embodiments in the specification,” while the patentee would want “the claims . . . construed to embrace more than the specification.” *Id.*

description grounds.”³¹⁵

As noted above, Circuit Judge Lourie also bypassed an invocation of the term “possession,” even though the *LizardTech* (2005) court expressly invoked the term.³¹⁶ With both Circuit Judge Lourie and Circuit Judge Rader talking around “possession,” it sounds like some kind of judicial mysticism—or an elephant in the courtroom.

D. An Evolving Mystical Expression

In 1991, *Vas-Cath* described the possession test and enablement as separate requirements.³¹⁷ Sometime thereafter, confusion set in, even in the same case. In *Enzo Biochem*, the court struggled with defining the possession test by saying that “[e]nabling one of skill in the art to make and use the invention is a separate requirement.”³¹⁸ One example the court provided was that “[a] description of [the invention] . . . in terms of . . . function . . . fails to distinguish [the invention] from others having the same activity or function.”³¹⁹ This seems fairly clear until we see that in the same opinion, the court said that “possession . . . is only a criterion for satisfying the statutory written description requirement[, it] is not necessarily equivalent to providing a written description.”³²⁰ Adding further to the confusion was the *LizardTech* (2005) court, which said that the written description “[1] must describe the manner and process of making and using the invention so as to enable a person of skill in the art to make and use the full scope of the invention without undue experimentation [,and, (2)] describe the invention sufficiently to convey to a person of skill in the art that the patentee had possession of the claimed invention at the time of the application, *i.e.*, that the patentee invented what is claimed.”³²¹ As a two-part description, this discussion clarifies, as in *Vas-Cath*, that the written description is two parts, enablement (under the PHOSITA test), and possession (a full description of the invention at the time of filing).³²²

Instead of continuing this distinction, the *LizardTech* (2005) court then tied enablement and possession together and made them interchangeable.³²³ “[A] recitation of how to make and use the invention across the full breadth of the claim is ordinarily sufficient to demonstrate that the inventor possesses the full scope of the invention, *and vice versa*.”³²⁴

As Circuit Judge Rader recognized, the *LizardTech* (2005) court had reverted back to the *Enzo Biochem* confusion by not “providing [a] neutral standard of application, [other than saying] . . . the specification must show ‘possession’ of the

³¹⁵ *Id.* at 1376.

³¹⁶ *LizardTech*, 424 F.3d at 1345.

³¹⁷ *Vas-Cath*, 935 F.2d at 1563.

³¹⁸ *Enzo Biochem*, 285 F.3d at 972 (Lourie, J., concurring).

³¹⁹ *Enzo Biochem*, 285 F.3d at 968 (Lourie, J., concurring).

³²⁰ *Enzo Biochem*, 323 F.3d at 973 (Lourie, J., concurring).

³²¹ *LizardTech*, 424 F.3d at 1344-45.

³²² *Vas-Cath*, 935 F.2d at 1563.

³²³ *LizardTech*, 424 F.3d at 1345.

³²⁴ *Id.* at 1345 (emphasis added).

claimed invention.”³²⁵ In doing so, the *LizardTech* court had once again tossed the enablement requirement and the possession test together without regard as to which they were applying.³²⁶ This lack of distinction is problematic in that rather than “explaining a neutral standard for applying written description, *LizardTech* seems to fall back on enablement, using the latter as a proxy for the former.”³²⁷

The opinion of this author is that by focusing on the requirements of 35 U.S.C. § 112, paragraph 1, the Court of Appeals for the Federal Circuit has confused the written description requirement with the requirement of 35 U.S.C. § 112, paragraph 2 for claims that particularly point out and distinctly disclose the elements of the invention. Circuit Judge Rader well summarized this confusion. “*LizardTech*’s two clear statements of written description law, [the written description must establish] that the patentee invented what is claimed, and, *an originally filed claim* can provide the requisite written description, are relegated to bookends *surrounding an enablement-based application* of the new written description doctrine.”³²⁸ As Circuit Judge Rader noted above, the focus in *LizardTech* is on the *claim* in the specification (claim 21 specifically). Yet, the word “claim” does not appear in the first paragraph of 35 U.S.C. § 112. In focusing on the possession of enablement in the written description, the Court of Appeals for the Federal Circuit has overlooked the second paragraph of § 112 which requires a “specification [that] particularly point[s] out and distinctly claim[s] the subject matter which the applicant regards as his invention.” Consequently, the difficulty the Court of Appeals for the Federal Circuit has with possession does not lie with the enablement requirement of §112(1), but with the definiteness requirement of §112(2). As the U.S. Supreme Court said in *Evans*, the purpose of the specification of a patent is “to put the public in possession of what the party *claims* as his own invention.”³²⁹ In focusing on enablement, the Court of Appeals for the Federal Circuit has misplaced the focus from “[t]he name of the game is the claim.”³³⁰

E. Mystical Precedent

While bringing focus on the possession test, *LizardTech* (2006) did not answer any questions helpful to resolve the written description dichotomy of enablement and possession.³³¹ One question might be the origin, but this author suspects the court would disagree even about that. Circuit Judge Rader cited *Enzo Biochem* (2002) as point of origin for the “court[’s] search[] for a proper standard

³²⁵ *LizardTech*, 433 F.3d at 1378 (Rader, J., dissenting).

³²⁶ *Id.* at 1345.

³²⁷ *LizardTech*, 433 F.3d at 1380 (Rader, J., dissenting).

³²⁸ *Id.* at 1380 (citing *LizardTech*, 424 F.3d at 1345-46. (Fed. Cir. 2005)).

³²⁹ *Evans v. Eaton*, 20 U.S. 356, 430-433 (1822).

³³⁰ *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998), (Clevenger, J., quoting Judge Giles Sutherland Rich, *Extent of Protection and Interpretation of Claims--American Perspectives*, 21 Int’l Rev. Indus. Prop. & Copyright L. 497, 499 (1990)).

³³¹ *Id.* at 1378 (Rader, J., dissenting) (citing *LizardTech*, 424 F.3d at 1345).

for its revised and evolving written description doctrine.”³³² In *Enzo Biochem*, the Court of Appeals “scuttled the “bright line” *Lilly* (1997) test for written description invalidity.”³³³ This author, however, traces the written description muddle to at least *Vas-Cath* (1991) which, in the opinion of this author, “appl[ied the] “possession” test . . . in a way not contemplated by the original test.”³³⁴ Regardless of the starting point, the difficulty has been “the impossibility of finding a standard that measures the sufficiency of the disclosure in a specification by comparing two parts of that same specification.”³³⁵ This may be understandable where, “[t]he descriptive text needed to meet [the evolving written description requirement] . . . will vary with *differences* in the state of the *knowledge* in the *field* and differences in the *predictability* of the *science*.”³³⁶ However, it is doubtful that anyone wants a patent system that requires the patentee to “[b]ring [the] specifications to the Federal Circuit and we will tell you if they contain sufficient descriptions.”³³⁷

LizardTech (2006) at least showed that “it is apparent that a significant number of Federal Circuit judges agree that this court’s evolving written description doctrine needs clarification.”³³⁸ “My vote to deny en banc review, however, should not be taken as an endorsement of our existing written description jurisprudence.”³³⁹ “Perhaps the entire line of [written description] cases stemming from *Ruschig* is wrong, and perhaps we should at some point address that question en banc.”³⁴⁰

However, *LizardTech* also showed “the court is in no hurry to clarify the issue.”³⁴¹ “Future panel opinions may provide the necessary clarity.”³⁴² “I take no position on that issue at this juncture.”³⁴³ Thus, Circuit Judge Rader is undoubtedly correct that “as this court’s case law creation strays farther from the statute, its application only gets more strained.”³⁴⁴ While *LizardTech* is but one more case that makes perpetuates the confusion, it likely will not be the last.

³³² *Id.* at 1378-79 (Rader, J., dissenting).

³³³ *Id.* at 1378-79 (Rader, J., dissenting) (citing *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559 (Fed. Cir. 1997)).

³³⁴ *Id.* at 1378 (Rader, J., dissenting) (citing *LizardTech*, 424 F.3d at 1345).

³³⁵ *Id.* at 1379 (Rader, J., dissenting).

³³⁶ *Id.* at 1379 (Rader, J., dissenting) (quoting *Capon*, 418 F.3d at 1357-59 (emphasis added)).

³³⁷ *Id.* at 1379 (Rader, J., dissenting).

³³⁸ *Id.* at 1381 (*See* *Univ. of Rochester v. G.D. Searle Co.*, 375 F.3d 1303, 1304 (Fed. Cir. 2004) (Newman, J., dissenting from the denial of rehearing en banc); *Id.* at 1307 (Gajarsa and Linn, JJ., joining Rader, J., dissenting from the denial of rehearing en banc)).

³³⁹ *Id.* at 1381 (citing *Rochester*, 375 F.3d at 1304 (Fed. Cir. 2004) (Dyk, J., concurring in the denial of rehearing en banc)).

³⁴⁰ *Id.* at 1381 (citing *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1328 (Fed. Cir. 2003) (Bryson, J., concurring)).

³⁴¹ *Id.* at 1381 (*See* *Rochester*, 375 F.3d at 1304 (denying petition for rehearing en banc); *Enzo Biochem*, 323 F.3d at 970 (Fed. Cir. 2002) (denying petition for rehearing en banc)).

³⁴² *Id.* at 1381 (citing *Rochester*, 375 F.3d at 1327 (Fed. Cir. 2004) (Dyk, J., concurring in denial of en banc review)).

³⁴³ *Id.* at 1381 (citing *Moba*, 325 F.3d at 1328 (Fed. Cir. 2003) (Bryson, J., concurring)).

³⁴⁴ *Id.* at 1381.

V. CONCLUSION

A. From the Judicial Point of View: Show Possession

Through this mud of judicial doctrine, Circuit Judge Rader provided two clear statements for practitioners and the judiciary. For practitioners, Circuit Judge Rader gave this gem: “The ostensible standard for an adequate written description is that the specification must show possession of the claimed invention.”³⁴⁵ As yet (2007) the court has not clarified the position of the possession doctrine to the written description. This author agrees with Circuit Judge Rader, who gave the judiciary this admonishment: “From my perspective, this court should not postpone further en banc reconsideration of its evolving written description doctrine.”³⁴⁶

Until the Court of Appeals for the Federal Circuit does give an en banc definition, or a retreat from possession, the patent bar will suffer from the lack of a definition of what the Court of Appeals for the Federal Circuit considers the requirements of possession.

B. From the Statutory Point of View: Enablement and Definiteness

While the *JVW*³⁴⁷ holding might seem inconsistent with *LizardTech*; the cases presented here, and the discussion in this article show that the Federal Circuit Court of Appeals is requiring patentees to show one thing. “An applicant complies with the written description requirement by describing the invention, with all its claimed limitations.”³⁴⁸

The *JVW* patentee won against the Interact V3 because, as the comparative patent drawing and Interact V3 photograph show, the V3 mirrored the patented invention almost identically.³⁴⁹ On the other hand, the *JVW* patentee lost against the Interact V4 because the specification did not provide a discussion of any means for lockably receiving the video game controller other than the L-shaped clips.

Similarly, *LizardTech* lost claim 21 and its dependent claims because the claim omitted a necessary element and specification failed to demonstrate how someone could operate the patented method without “maintaining updated sums.”³⁵⁰ The cases discussed here show that the Court of Appeals for the Federal Circuit requires patentees to delineate every element and every embodiment in sufficient detail, so that of the filing date, the specification enables a person having skill in the field of art to understand how to make the invention, how to use the invention, and the inventor’s best mode. The problem with the possession doctrine

³⁴⁵ *Id.* at 1378.

³⁴⁶ *Id.* at 1381.

³⁴⁷ *See generally JVW Enters.*, 424 F.3d at 1324.

³⁴⁸ *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1479 (Fed. Cir. 1998) (discussed *supra*) (quoting *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997)).

³⁴⁹ *JVW Enters.*, 424 F.3d at 1333.

³⁵⁰ *LizardTech*, 433 F.3d at 1377.

is, as Circuit Judge Rader said: “Bring your specifications to the Federal Circuit and we will tell you if they contain sufficient descriptions.”³⁵¹ Both 35 U.S.C. § 112 and judicial doctrine provide for broad claim construction through means plus function, the doctrine of equivalents and genus-species claims.³⁵² The possession doctrine restricts the ability of the patentee to use these statutes and doctrines.

C. From the Practitioner Point of View

The author reviewed many cases not cited here. This research leads the author to believe that the Court of Appeals for the Federal Circuit has created a two-headed monster for itself and the patent bar. One side wants more disclosure of enablement and definiteness to explain new technologies for which the courts and art are unprepared. The other side wants to keep the balance of technology and patent innovation moving forward.

Rather than clearly state the requirement, the Court of Appeals for the Federal Circuit once coined a buzzword named possession and is now reluctant to back away from precedent, even though it disclaims *stare decisis*—the elephant in the courtroom.

With this greater disclosure requirement in mind, this author supports Circuit Judge Rader’s admonition that the Court of Appeals for the Federal Circuit has an “evolving written description doctrine.”³⁵³ While patent prosecution standards were due for tightening in the face of criticism over lax issue policies, the role of the judiciary is interpretation of statutes. By creating the possession doctrine and loosely applying this judicial requirement, the Court of Appeals for the Federal Circuit is expanding judicial doctrine beyond the statutory constraints of 35 U.S.C. § 112.

Regardless of whether in the greater scheme of patent practice and litigation the *LizardTech* court got it right, interpretations such as *JVW* will become rare if not extinct. As Circuit Judge Rader commented, patent practitioners are in a “quandary.”³⁵⁴ The possession test is not a detailed requirement, but rather is a “requirement of detail” unlike any checklist within case law or the Manual of Patent Examining Procedure.

As a practitioner, this author agrees that the Court of Appeals for the Federal Circuit must abide by precedent and fully explain its rationale. The void of explanation creates unnecessary effort for practitioners in drafting applications and unnecessary expenses. Compounding matters is that a longer application is not necessarily more definitive. District courts will struggle with longer applications, and increasing reversal rates.

The judiciary will likely take a decade to resolve this newest doctrine. Patent practitioners need answers now for present and future claim construction issues to secure the widest permissible patent rights without invalidation or litigation

³⁵¹ *Id.* at 1379 (Rader, J. dissenting).

³⁵² *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 609, 70 S.Ct. 854 (1950); *Enzo Biochem*, 323 F.3d at 966-67.

³⁵³ *Id.* at 1376-81.

³⁵⁴ *Id.* at 1376.

negating the purpose of the patent. While technology, biology and even language evolve, interpretation of the written description, concluding with the claims, must be sufficiently unchanging such that it does not frustrate the constitutional mandate that intellectual property serves which is “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to . . . Inventors the exclusive Right to their . . . Discoveries.”³⁵⁵

³⁵⁵ U.S. Const., art. I, § 8, cl. 8.